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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1900.

No. 242.

ANDREW H. RUSSELL AND WILLIAM R. LIVERMORE, APPELLANTS,

vs.

THE UNITED STATES.

APPEAL FROM THE COURT OF CLAIMS.

FILED APRIL 5, 1900.

(17,704.)

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1 Court of Claims.

ANDREW H. RUSSELL and WILLIAM R. LIVERMORE
vs.
THE UNITED STATES. } No. 20883.

I.—*Petition.*

The claimants filed their original petition on the 18th day of September, 1897, and on February 7, 1899, by leave of court, they filed the following amended petition, to wit:

Amended Petition. Filed February 7, 1899.

To the honorable the Chief Justice and judges of the Court of Claims:

Andrew H. Russell and William R. Livermore respectfully show unto your honorable court, that whereas:

1. The claimants are citizens of the United States and officers of the United States Army.

2. On or about January 9, 1880, the claimant Russell made application, in due form, for letters patent of the United States for his invention of certain new and useful improvements in breech-loading guns, and thereafter, on or about August 3, 1880, letters patent of the United States, numbered 230,823, were granted to the
2 said Russell for and upon the same. A copy of the said letters patent duly certified is here in court, ready to be produced.

3. By an assignment, bearing date February 4, 1891, the claimant Russell transferred and conveyed to the claimant Livermore an undivided one-half interest in the said invention and letters patent. Thereafter, the claimant Livermore, by an assignment bearing date February 21, 1893, transferred and conveyed to the claimant Russell one-third of an undivided one-half interest in the said letters patent and invention. Thereafter, by an assignment bearing date October 7, 1898, the claimant Livermore transferred and conveyed all of his right, title, and interest in and to the said invention and letters patent, to the claimant Russell.

4. Pursuant to an advertisement of a board of officers of the United States Army, convened, pursuant to an act of Congress approved February 4, 1881, for the purpose of selecting a magazine rifle for the military service of the United States, the claimant Russell submitted to the said board an operative magazine rifle, made in accordance with the device described in the said letters patent, number 230,823; and on or about December 16, 1890, the claimant Russell again submitted the said rifle to a board of officers of the United States Army, which was convened for the like purpose. The said boards made reports, which are to be found in the following publications of the Government: Board of 1881, see report of the

chief of ordnance for 1882 (Ho. Ex. Doc. No. 1, 47th Cong., 2d sess., pt. 2, vol. 3, pp. 329 *et seq.*); board of 1892, see report of the chief of ordnance for 1893 (Ho. Ex. Doc. No. 1, 53d Cong., 2d sess., pt. 2. vol. 3, pp. 132 *et seq.*) It is prayed that the relevant portions of these two reports be treated as a part of this petition.

5. On or about September 15, 1892, the second board recommended the adoption of the magazine rifle presented to it by
3 the Krag-Jorgensen Gevaerkompagni, of Christiania, Norway, which will hereinafter be termed the "Army rifle," and the said rifle was then provisionally adopted by the War Department for the use of the United States Army.

6. On November 16, 1892, the claimant Russell, acting for the claimant Livermore and himself, directed a letter to the chief of ordnance, U. S. Army, and stated therein that the inventions described in and protected by the said letters patent number 230,823 were embraced, embodied, and included in the said "Army rifle," and requested the chief of ordnance to make provision for the payment of compensation to these claimants by the United States for and on account of the use of the said patent, in the proposed manufacture of the said "Army rifles." (A copy of said letter is hereunto annexed, marked "Exhibit A," and made part hereof.)

7. On November 18, 1892, the Ordnance Department replied to the said letter of the claimant Russell, stating that its business arrangements with the Krag-Jorgensen Gevaerkompagni for the manufacture of the said "Army rifle" had not been completed; that the said company might agree to indemnify the United States for any damages it might sustain on account of the use of any patent rights which might be used by the United States in the manufacture of the said "Army rifles," and thereby the claimants would be provided with a remedy to be obtained from the said company; or the Government might proceed to manufacture the said "Army rifles" without such an arrangement, in which case the claimants could obtain their remedy by suit against the United States in the Court of Claims, after the manufacture had progressed. (A copy of the said letter is hereunto annexed, marked "Exhibit B," and made part hereof.)

4 8. On December 9, 1892, the claimant Russell, acting for the claimant Livermore and himself, directed a letter to the chief of ordnance of the U. S. Army, in which he stated that the claimants could obtain no adequate remedy against the Krag-Jorgensen Gevaerkompagni for an infringement of their patent, because the said company was a foreign corporation, and had no property in the United States upon which the claimants could levy to satisfy a judgment, and the claimant Russell therein repeated his request made in his said letter of November 16, 1892, that the chief of ordnance provide for the payment of compensation to the claimants. (A copy of the said letter is hereunto annexed, marked "Exhibit C," and made part hereof.)

9. Thereafter, the Ordnance Department directed a letter to the claimant Russell, informing him that certain investigations were being made in the Patent Office with regard to the said "Army

rifle," and advising that the claimants present their claim to the Commissioner of Patents. Pursuant thereto the claimant Russell, acting in behalf of the claimant Livermore and himself, directed a letter to the Commissioner of Patents, wherein he claimed that the said "Army rifle" embraced, embodied, and included the inventions described in and protected by the claimants' said patent. In reply thereto the Commissioner of Patents directed a letter to the claimant Russell, wherein he declined to exercise any jurisdiction over the said claim. (Copies of the said letters are hereunto annexed, marked "Exhibits D, E, and F," respectively, and are made part hereof.)

10. On June 30, 1893, the claimant Russell, acting in behalf of the claimant Livermore and himself, directed a letter to the chief of ordnance of the United States Army, saying that he had presented his claim to the Commissioner of Patents, as advised by the Ordnance Department, and that the Commissioner of Patents had
5 declined to take jurisdiction over the case. The claimant Russell therefore renewed the request contained in his letter of November 16, 1892, and asked that the Ordnance Department allow him a hearing before any business arrangements with the Krag-Jorgensen Gevaerkompagni were closed. (A copy of said letter is hereunto annexed, marked "Exhibit G," and made part hereof.)

11. On July 7, 1893, the letter last above mentioned was returned to the claimants with an endorsement by the Ordnance Department wherein the claimants were advised to present a statement of the case in writing, to be filed in the Ordnance Department for future reference. It was stated further that an agreement had been made between the War Department and the Krag-Jorgensen Gevaerkompagni, whereby the latter was required to indemnify the United States against all damages for infringement of patent rights which might arise in the manufacture of the said "Army rifle." (A copy of the said endorsement is hereunto annexed, marked "Exhibit H," and made part hereof.)

12. In compliance with the request contained in the said endorsement, the claimant Russell, acting for the claimant Livermore and himself, on November 22, 1893, directed a letter to the chief of ordnance wherein he made a full statement of the claimants' case and stated the particulars wherein the said "Army rifle" embodied and contained inventions described in and protected by the claimants' said letters patent 230,823. (A copy of this letter is hereunto annexed, marked "Exhibit I," and made part hereof.)

13. On December 1, 1893, the Ordnance Department directed a letter to the claimant Russell, in which it cited a provision contained in an agreement between the United States and the Krag-Jorgensen Gavaerkompagni, and stated that the claim of the said Russell and
6 Livermore could not be determined by the Ordnance Department. (A copy of the said letter is hereunto annexed, marked "Exhibit K," and made part hereof.)

14. On June 7, 1893, the said Krag-Jorgensen Gevaerkompagni and the United States, represented by Brigadier General D. W. Flagler, U. S. Army, chief of ordnance, acting in its behalf, under the direction and by authority of the Secretary of War, entered into

a contract whereby it was, *inter alia*, provided that the said company granted to the United States the right to manufacture an unlimited number of the said "Army rifle" for the military service of the United States, under letters patent of the United States numbered 429,811, issued on June 10, 1890, and 491,212, issued on February 21, 1893, both of which letters patent were granted to O. W. G. Krag and E. Jorgensen, for the sum of one dollar ($1.00) per arm for all firearms manufactured by the United States during the lifetime of said patents; that the said company claimed that all the mechanism of the said "Army rifle" not open to public use was duly covered and protected by its said patents; and it was further agreed that, before any royalties were paid by the United States, the said company should furnish a good and sufficient bond in the penal sum of twenty-five thousand dollars ($25,000) to protect and defend the United States against all suits and claims by any and all persons for the infringement of their inventions in the manufacture of the said "Army rifles," and to pay all judgments that might be obtained against the United States for the same, and it was further provided that the said company should indemnify the United States, and all persons acting under them, for all liability on account of any patent rights granted by the United States which might affect the right to manufacture in the said contract provided for; and it was further agreed that
7 the United States should pay to the said company the royalty above mentioned upon the number of the said "Army rifles" duly certified as manufactured by the proper officers of the Ordnance Department. (A copy of the said contract is hereto annexed, marked "Exhibit L," and made part hereof.)

15. Thereafter the United States proceeded to manufacture the said "Army rifles," and on or about January 1, 1894, did manufacture and introduce for service in the United States Army, and use, and has since then continued to so manufacture and use the said "Army rifles," and the United States did then and has since continued to account to the Krag-Jorgensen Gevaerkompagni for royalties at the rate named in the said contract, and did pay over to the said company certain sums on account thereof, but the said company failed to furnish a bond to indemnify the United States as in the said contract provided, and the United States for its indemnity and in lieu of such bond did, from time to time, prior to June 16, 1896, with the consent of the said company, withhold payment to it of sums payable on account of the said royalties, which sums so retained did, on or about June 16, 1896, amount, to wit, to upwards of twenty-five thousand dollars ($25,000), and, on or about June 16, 1896, the Krag-Jorgensen Gevaerkompagni did furnish to the United States a bond, with sureties, in the penal sum of twenty-five thousand dollars ($25,000), conditioned as follows:

"That whereas the Krag-Jorgensen Gevaerkompagni of Christiania, Norway, has, on the seventh day of June, 1893, entered into a contract with the United States, represented by Brigadier General D. W. Flagler, chief of ordnance, for granting unto the United States full rights to manufacture an unlimited number of the Krag-Jorgensen magazine firearms, for the military service of the United States,

under the American patents, Nos. 429,811, of June 10, 1890,
8 and 492,212, of February 21, 1893, granted to O. W. J. Krag and E. Jorgensen, during the lifetime of the said patents, and by the said contract covenanted to indemnify the United States, and all persons acting under them, for all liability on account of any patent rights granted by the United States which may affect the right to manufacture therein contracted for, and further covenanted and agreed to furnish, before the payment of any royalties by the United States, a good and sufficient bond in the penal sum of twenty-five thousand dollars, to protect and defend the United States against all suits and claims by any and all persons for infringement of their inventions in the manufacture of said arms, and to pay all judgments that may be obtained against the United States for the same:

"Now, therefore, if the said Krag-Jorgensen Gevaerkompagni shall and will in all respects indemnify the United States, and all persons acting under them, for all liability on account of any patent rights granted by the United States which may affect the right to manufacture granted by said contract, and shall and will fully protect and defend the United States against all suits and claims by any and all persons for infringement of their inventions in the manufacture of said arms, and pay all judgments that may be obtained against the United States, or any officer or agent thereof for the same, then the above obligation shall be void and of no effect; otherwise to remain in full force and virtue."

And the United States did thereupon accept the said bond, and paid over to the Krag-Jorgensen Gevaerkompagni the sum theretofore withheld by the United States to indemnify it, as aforesaid.

16. From time to time, between January 1, 1894, and the date of the filing of this amended petition, the United States did manufacture and introduce for service in the United States Army, and use, large numbers of the said "Army rifles," to wit, upwards of seventy-five thousand thereof.

9 17. All of the said "Army rifles," manufactured and used by the United States, as aforesaid, embraced, embodied, and included the inventions belonging to the claimants and described in and protected by the claimants' said letters patent No. 230,823, and not protected by the said letters patent of the Krag-Jorgensen Gevaerkompagni, and by reason thereof the United States derived great benefit and profit, to wit, a benefit and profit of upwards of one ($1.00) dollar on each one of the said "Army rifles."

By reason of the foregoing facts, the claimants say:

(1.) That neither the said contract, entered into by the United States and the Krag-Jorgensen Gevaerkompagni (Exhibit L) nor the said bond of indemnity delivered by the said Krag-Jorgensen Gevaerkompagni to the United States, did provide the claimants with a remedy against the said Krag-Jorgensen Gevaerkompagni, for the use made by the United States of the claimants' said patented invention in accordance with the first alternative proposed by the Ordnance Department in its said letter to the claimant Russell, bearing date November 18, 1892 (Exhibit B).

(2.) That there is to be implied from the use by the United States of the claimants' said patented invention, as hereinbefore related, a contract, whereby the United States agreed to pay to the claimants reasonable compensation for the same, and whereby the amount of such compensation was to be ascertained by means of a suit to be brought by the claimants in this court, in accordance with the second alternative proposed in the said letter (Exhibit B), and that the sum of $100,000 would be reasonable compensation for the said use, and that the United States has failed to pay the claimants the said sum of $100,000 or any sum, or sums, whatsoever for or on account of the said use, although duly requested thereunto.

10 The claimants are the only persons owning or interested in the claim above set forth, and no assignment or transfer of the said claim or of any part thereof or interest therein, has been made. The claimants are justly entitled to receive and recover from the United States the sum of one hundred thousand dollars ($100,000), after allowing all just credits and offsets. The claimants have always borne true allegiance to the Government of the United States, and have not in any way aided, abetted, or given encouragement to rebellion against the said Government, and they believe the facts hereinabove stated to be true.

Wherefore the claimants pray for judgment against the United States in the sum of one hundred thousand dollars ($100,000) and for such further relief as this honorable court may be entitled to grant, both at law and in equity, in the premises.

ANDREW H. RUSSELL.
WILLIAM R. LIVERMORE.

McCAMMON & HAYDEN,
Attorneys for Claimants.

STATE OF ILLINOIS, }
County of Cook, } ss:

Andrew H. Russell, being duly sworn, deposes and says that he is one of the claimants named in and who subscribed the foregoing amended petition; that he has read the same and knows the contents thereof, and that the facts herein stated are true to the best of his knowledge and belief.

ANDREW H. RUSSELL.

Sworn to and subscribed before me this fourth (4) day of February, A. D. 1899.

[SEAL.] WALTER L. FISHER,
Notary Public.

11 EXHIBIT A.

(Copy.)

WASHINGTON, D. C., *November* 16, 1892.

To the chief of ordnance, U. S. Army.

SIR: In the interest of Major Wm. R. Livermore, U. S. Army, and myself, I have the honor to invite attention to claims 22, 28, and 29

in U. S. patent No. 230,823, owned by us, as we believe their provisions to be infringed in the construction of the Krag-Jorgensen magazine gun lately adopted by the War Department, the points of resemblance being in the connection between the magazine and the receiver.

In considering the allowance to inventors, we would request that our claims for these vital points of construction be regarded.

Very respectfully, your obedient servant,

(Signed) A. H. RUSSELL,
Capt. of Ordnance, U. S. Army.

EXHIBIT B.

5839.

ORDNANCE OFFICE, WAR DEPARTMENT,
WASHINGTON, *November* 18, 1892.

Capt. A. H. Russell, Ordnance Department, U. S. A., cor. 15th St. & N. Y. Ave., Washington, D. C.

SIR: In reference to your letter of the 16th instant claiming the use of your patent right in the Krag-Jorgensen gun, lately
12 adopted by this department for trial, which has been received and placed on file, I am instructed by the chief of ordnance to inform you that the business arrangements with the Krag-Jorgensen Company for the manufacture of this arm have not yet been completed.

On the one hand, that company may agree to indemnify the United States on account of any patent rights granted by the United States which may affect the manufacture of the guns, in which case your recourse would be to communicate directly with the company.

On the other hand, should the Government proceed to manufacture the arms without such arrangement, your course will be to bring a suit against the Government in the Court of Claims after manufacture has progressed.

Respectfully,

(Signed) C. W. WHIPPLE,
Capt. Ord. Dept., U. S. A.

EXHIBIT C.

WASHINGTON, D. C., *December* 9, 1892.

To the chief of ordnance, U. S. Army.

SIR: In reference to my letter to the chief of ordnance of November 16, 1892, and to the answer of November 18th from the Ordnance Office in reply thereto, concerning the claims 22, 28, and 29 in the U. S. patent to me, No. 230,823 (a copy of the specifications on which was enclosed in my letter), I desire to say that I could practically have no remedy for infringement of my patent against the Krag-Jorgensen Company, as they have not, that I am

aware of, any property in this country; and also that I presume it would be more satisfactory to the United States, as it certainly would be to me, to have whatever may be justly due to me on my patents allowed without litigation.

13 I therefore hope that the Ordnance Office will bear my letter of November 16th, and this letter, in mind, and allow me a hearing before any business arrangement with the Krag-Jorgensen Company is closed.

Very respectfully, your obedient servant,

(Signed) A. H. RUSSELL,
Capt. of Ordnance, U. S. Army.

EXHIBIT D.

ORDNANCE OFFICE, WAR DEPARTMENT,
WASHINGTON, *December* 19, 1892.

Capt. A. H. Russell, World's Columbian Exposition, Chicago, Ill.

SIR: Referring to your letters of the 16th ult. and the 9th inst., on the subject of infringement of your patent in the manufacture of the Krag-Jorgensen magazine firearm, I am instructed by the chief of ordnance to inform you that in a letter received from the Commissioner of Patents dated 15th inst. he states that the invention of H. I. Krag and Erik Jorgensen for improvement in machine firearms has been examined and the invention has been found patentable in view of the state of the art, but that other applications are pending which appear to conflict in subject-matter; therefore the application of Krag and Jorgensen will be withheld from issue until that question is settled definitely.

I am also instructed to inform you that in a letter to the Commissioner of Patents, dated 16th inst., the chief of ordnance transmitted to him copies of your above-mentioned letters of 16th ult. and 9th inst.

14 Should you desire further presentation of your patent, it is suggested that you communicate direct with the Commissioner of Patents.

Respectfully,

(Signed) CHARLES SHALER,
Capt. Ord. Dept., U. S. A.

EXHIBIT E.

1429 NEW YORK AVE.,
WASHINGTON, D. C., *February* 6, 1893.

To the Commissioner of Patents.

SIR: In an official communication from the chief of ordnance U. S. A., dated December 19, 1892, it is suggested that I "communicate direct with the Commissioner of Patents" in regard to the following matter.

I presented to the Ordnance Office the claim that the gun recommended for adoption by the U. S. Army, known as the Krag-

Jorgensen gun, infringed claims 22, 28, and 29 of my patent No. 230,823, dated August 3, 1880, and I asked that the Government do justice by me in case of using such device.

The chief of ordnance states that there were claims now pending in the Patent Office, and referred me to you, with the information that copies of my letters had been sent you December 16, 1892.

Copies of these letters are enclosed, with copies of replies from the Ordnance Office.

I have the honor to inquire what further action should be taken by me.

Very respectfully,

(Signed) A. H. RUSSELL.

15 EXHIBIT F.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *February* 14, 1893.

Capt. A. H. Russell, U. S. A., 1429 New York avenue, Washington, D. C.

SIR: I have your letter of the 6th instant, and in reply you are advised that it is not seen how the Patent Office has any jurisdiction in the matter concerning which you write. Questions of infringement can be determined only by the courts.

Very respectfully,

(Signed) W. E. SIMONDS,
Commissioner.

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EXHIBIT G.

CHICAGO, ILL., *June* 30, 1893.

To the chief of ordnance, U. S. Army, Washington, D. C.

SIR: In reference to correspondence regarding infringement of my patent No. 230,823 by the manufacture of the Krag-Jorgensen magazine rifle recommended by the magazine gun board, I have the honor to state that I communicated direct with the Commissioner of Patents, as suggested in the letter of December 19, 1892, from the Ordnance Office, and was told that the Patent Office had no jurisdiction. The patent infringed is one of long standing, and no
16 claim is made that the Krag-Jorgensen patents infringe, but it is claimed that the construction of the gun embodying those patents does infringe my patent of 1880.

I therefore respectfully renew the request contained in my letter of December 9, 1892, that the Ordnance Office will "allow me a hearing before any business arrangement with the Krag-Jorgensen Company is closed."

Very respectfully, your obedient servant,

(Signed) A. H. RUSSELL,
Capt. of Ord., U. S. Army.

EXHIBIT H.

(1st endorsement.)

ORDNANCE OFFICE, WASHINGTON, *July* 7, 1893.

Respectfully returned to Capt. A. H. Russell, Government building, Jackson park, Chicago, Ill., with information that a statement of this case should be made in writing for file at this office, and for future reference, as the case stated cannot be determined by the Ordnance Office.

The agreement with the Krag-Jorgensen people is such that they are required to guarantee the U. S. against all damages for infringement.

(Signed) CHARLES SHALER,
Acting Chief of Ordnance.

EXHIBIT I.

CHICAGO, ILL., *November* 22, 1893.

To the chief of ordnance, U. S. Army, Washington, D. C.

SIR: In response to your communication of July 7, 1893, in the 1st endorsement on my letter of June 30, 1893, Ordnance
17 Office files 3515 of 1893, I hereby respectfully state my position with regard to the Krag-Jorgensen rifle construction recently adopted for the U. S. Army, and now in process of manufacture at the Springfield armory.

I do not claim to be the inventor of all the mechanism of said gun. There are probably several important and meritorious inventions involved. The grant of a patent by the Patent Office on some features, however, does not authorize the making or using of other features covered by other patentees, as I am informed, and as seems a reasonable construction of law.

The specific features used in said gun and claimed by me, and believed to be covered by my U. S. patent No. 230,823 of August 3, 1880, are embraced in the 22d, 28th, and possibly in the 29th claims of said patent. A free description of the general features of my invention as used in the Krag-Jorgensen gun would be "a magazine feeding into the side of the receiver under a bridge, with the entrance way under the bridge narrowed at the rear of the receiver, so as to permit but a slight projection of the side of the cartridge into the receiver when the bolt is drawn back, but with a wider opening further forward, so that as the cartridge moves forward impelled by the bolt, it will find a full-width passage under the bridge, through which it passes into the receiver."

This bridge and magazine opening is described in my patent, referred to, page 6, lines 100 *et seq.*, as follows:

"In filling the chamber of the magazine the gate is forced downward as the cartridges are filled in, leaving ample space to insert cartridges between the top edge of the magazine wall and a bridge or top part, M, and thus supply the magazine. When relieved of

the downward pressure the gate ascends far enough to prevent egress of cartridges in any other way than sidewise from the magazine mouth into the receiver B′ beneath the bridge.

18 "The bridge M is of peculiar formation on its under and inner surface, and is at one side of the longitudinal centre of the barrel and breech-bolt housing. (See particularly Figs. 9, 10, 11, 12, 13, and 14, where is represented the manner of curving or recessing the bridge so as to admit cartridges to the receiver and guide and control their movements as supplied to the receiver from the magazine mouth, and thence conducted to the firing chamber by the thrust of the breech bolt A^2.)

"Supposing the breech bolt to be retracted and about to be advanced, the operation of supplying and seating a cartridge from the magazine is as follows, reference being had to the last referred to figures and to Figs. 3, 4, and 6, ignoring for the present the hinged gate N: The topmost cartridge is elevated by the pusher against the bridge, so that its flange projects partially, but very slightly, into the path of travel of the breech-bolt head (see dotted lines, Fig. 11), and in which position it is prevented from accidental inward movement by a slight ridge or swell, *n*, (see Figs. 4 and 11) at the rear portion of the edge or wall of the opening in the receiver bottom, with which the magazine communicates, and by a similar ridge or downward swell, *n′*, on the bridge.

"The point or nose of the cartridge is guided past the spring *l* and into the firing chamber *b*, by the flaring way or incline *m* as the bolt advances.

"Before the cartridge has been moved forward far enough by the advance of the bolt to jam or bind crosswise, the flange will have been moved to a point where the two ridges *n n′* begin to slope respectively downward and inward gradually to the plane of the bottom or lowest part of the receiver, and upward and inward, thus allowing the flange to pass toward its place in the receiver. The bridge is also cut away on a curve or incline m^2, forward and inward from its lower edge to *m′*, so that as the front of the cartridge is entering the chamber the rear is being gradually brought into line therewith.

"About the time the flange has been advanced to the point indicated by *m′*, Fig. 9, the curved recess or incline m^2 of the inner and under side of the bridge, which had previously served

19 to gradually admit the inward passage of the flange, and which at this point terminates in a swell or ridge similar to *n′*, now serves to prevent its escape or outward movement and to direct it into the proper position to be pushed home and firmly seated by the bolt, as already described * * * The bridge M is shown as formed with or attached to the magazine. It may, however, obviously be formed with the shoe or breech of the gun partly over and at one side of the receiver chamber."

In the main, this description applies to the Krag-Jorgensen gun quite as well as to my own gun, and my opinion is confirmed by that of experts that this part of my construction has been adopted in that arm.

I am informed that my rights under my patent depend on the claims therein, and my belief is sustained by expert opinion that the Krag-Jorgensen gun under construction at Springfield infringes the 22d claim of my patent, which reads as follows:

"22. The combination of the shoe chamber or receiver, the bridge at the side and top of the receiver, and the magazine chamber having an inlet to receive the cartridges inserted downward outside and beneath the bridge, and a mouth by which to conduct them beneath the bridge into and at the side of the receiver, substantially as hereinbefore set forth."

Taking the elements of this claim separately, it will be seen that the Krag-Jorgensen gun has "the shoe or receiver." All bolt guns and many others have it. The Krag gun is, however, one of a few to have "the bridge at the side and top of the receiver." It also has "the magazine chamber having an inlet to receive the cartridges inserted downward outside and beneath the bridge." It is true the Krag-Jorgensen gun shows the loading opening in a different place from that illustrated in my patent, but my claim is not limited as to the exact location of the loading opening, and the whole tenor of my patent is against the theory that I am limited in this claim to the precise construction shown in my drawing. Further, I am informed that the rule of law is that a patent claim, if valid, covers its mechanical equivalents—that is, other devices operating in a similar way to a like result, which is certainly the case in this instance. My claim further specifies "a mouth by which to conduct them" (the cartridges) "beneath the bridge into and at the side of the receiver, substantially as hereinbefore set forth." This language, like the rest of the claim, applies quite as well to the Krag-Jorgensen gun as to the one invented and constructed by me.

It thus seems demonstrable that the Krag-Jorgensen gun, having adopted part of my invention, has also adopted that part covered by claim 22.

Claim 28 in my specified patent is as follows:

"28. The combination, substantially as hereinbefore set forth, of the reciprocating breech bolt, the shoe chamber or receiver, the magazine chamber having a mouth, as described, the cartridge-supplying mechanism, and the bridge M, having the ridge or swell n', and otherwise curved or recessed, substantially in the manner and for the purpose set forth."

The Krag-Jorgensen gun has "the reciprocating breech bolt, the shoe chamber or receiver, the magazine chamber having a mouth;" it has "cartridge-supplying mechanism;" and "the bridge having the ridge or swell" below the main part of the bridge and extending forward precisely in the same manner and for the same purpose as the swell n' of my patent, and is otherwise curved or recessed substantially in the manner set forth in my patent. I therefore feel warranted in the belief that my claim 28 covers the Krag-Jorgensen construction, and is infringed thereby.

Claim 29 of my patent is as follows:

21 "29. The bridge M, located relatively to the receiver and mouth of the magazine essentially as shown and described, and having the rear ridge n', and the curved or inclined surfaces m' and m^2, substantially as and for the purpose hereinbefore set forth."

The construction of the Krag-Jorgensen gun substantially conforms to the terms of this claim also, yet I am not quite certain that the bridge in that gun has a projection the equivalent of that described as m^2 in my patent. I presume this question can only be determined by careful expert examination.

I, therefore, base my claim for compensation on the infringement of my claims 22 and 28, and the probable infringement of claim 29, in my said patent No. 230,823, of August 3, 1880, by the Krag-Jorgensen construction.

I am not fully informed as to the terms of the contract between the United States and the owners of the Krag-Jorgensen patent. Assuming that the owners of said patent are in ignorance of my rights in the premises, I respectfully request that a copy of this communication may be sent to said parties, and a duplicate of this paper is forwarded for that purpose, with an extra copy of my patent to go with the duplicate. I further request that I may be furnished with the name and address of the responsible parties representing the Krag-Jorgensen interest.

I am aware that in the event of a suit in equity, the alleged infringing parties have a statutory right to challenge the validity of my patent, and, to avoid litigation, I am willing to go further than to make a mere statement of the *prima facie* case as above, and show to infringing parties or their experts that my claims are well within my rights, provided I am met by these parties in a fair spirit, and with a desire to make just compensation when my title to the property is shown.

22 My first official notice to the Ordnance Department of this infringement is dated November 16, 1892 (Ordnance Office file 5839 of 1892), but a gun presenting the special features here mentioned was submitted by me to the board on magazine guns, convened by general orders 31, H. Q. A., March 21, 1881, and it is described in the report of that board. It is now in my possession subject to examination.

Very respectfully, your obedient servant,

(Signed) A. H. RUSSELL.

EXHIBIT K.

3515. (Copy.)

ORDNANCE OFFICE, WAR DEPARTMENT,
WASHINGTON, *December* 1, 1893.

Capt. A. H. Russell, Ordnance Department, U. S. A., Government building, Jackson park, Chicago, Ill.

SIR: I am instructed by the chief of ordnance to acknowledge the receipt of your letter of the 22d inst., and to inform you that the

terms of the contract between the United States and the Krag-Jorgensen Co. contain a clause to the following effect:

"The said party of the first part shall indemnify the United States and all persons acting under them for all liability on account of any patent rights granted by the United States which may affect the right to manufacture herein contracted for."

You have requested that a copy of your communication
23 and a copy of your patent should be forwarded by this office to the company, and for that purpose you have forwarded duplicates of your letter and of the patent specifications. It is considered best that you should forward these communications direct; they are, therefore, returned to you for the purpose. The address of the contracting company is "The Krag-Jorgensen Gewehr Kompagnie, Christiania, Norway." The other papers, enclosures to Ordnance Office file 3515, containing letter and copies of patent specifications, are filed in this office for future reference.

Your attention is again invited to the statement of the first endorsement on that file, which states that the case "cannot be determined by the Ordnance Department."

Respectfully,

(Signed) CHARLES SHALER,
Capt., Ord. Dept., U. S. A.

Exhibit L.

Articles of agreement entered into this seventh day of June, eighteen hundred and ninety-three, between the Krag-Jorgensen Gevarkompagni of Christiania, in the county of ——, State of Norway, of the first part, and the United States, by Brigadier General D. W. Flagler, chief of ordnance, acting under the direction and by authority of the Secretary of War, for and in their behalf, of the second part.

1st. This agreement witnesseth, that the said party of the first part, for themselves and their successors, etc., and the said party of the second part, for and in behalf of the United States of America, have mutually agreed, and by these presents do mutually covenant and agree, to and with each other, as follows, viz:

24 The said party of the first part does hereby contract and engage with the United States to grant unto the said United States full rights to manufacture an unlimited number of the Krag-Jorgensen magazine firearms for the military service of the United States, under the American patents, Nos. 429,811 of June 10, 1890, and 492,212 of February 21, 1893, granted to O. W. J. Krag and E. Jorgensen—and which said party of the first part claims fully cover all the mechanism of said magazine firearms not open to public use—for the sum of one dollar ($1.00) per arm for all firearms manufactured by the party of the second part during the lifetime of said patents.

It is further stipulated and agreed that the right to manufacture

magazine firearms herein granted shall also embrace and apply to all improvements which may hereafter be made or owned by the Krag-Jorgensen Gevarkompagni in these arms during the lifetime of the above-mentioned existing patents.

It is further stipuated and agreed that before any royalties are paid by the United States, the Krag-Jorgensen Gevarkompagni shall furnish a good and sufficient bond in the penal sum of twenty-five thousand dollars ($25,000.00), to protect and defend the United States against all suits and claims by any and all persons for infringement of their inventions in the manufacture of these arms, and to pay all judgments that may be obtained against the United States for the same.

2d. All the — herein contracted for shall be delivered by the said party of the first part.

3d. The said party of the first part shall indemnify the United States and all persons acting under them for all liability on account of any patent rights granted by the United States which may affect the right to manufacture herein contracted for.

4th. For the right to manufacture herein contracted for, which shall be delivered, inspected, and accepted as aforesaid, there shall be paid by the United States to the said party of the first part, on bills in duplicate, made in approved form, and duly authenticated by the proper officers of the Ordnance Department, the price aforementioned in the funds furnished for the purpose by the United States.

5th. If any default shall be made by the party of the first part in delivering all or any of the — mentioned in this contract, of the quality and at the times and places herein specified, then, in that case, the said party of the second part may supply the deficiency by purchase in open market or otherwise (the articles so procured to be of the kind herein specified as near as practicable), and the said party of the first part shall be charged with the expense resulting from such failure. Nothing contained in this stipulation shall be construed to prevent the chief of ordnance, at his option, upon the happening of any such default, from declaring this contract to be thereafter null and void, without affecting the right of the United States to recover for defaults which may have occurred; but in case of overwhelming and unfor-seen accident, by fire or otherwise, the circumstances shall be taken into equitable consideration by the United States before claiming forfeiture for nondelivery at the time specified.

6th. Neither this contract nor any interest therein shall be transferred by the said party of the first part to any other party; and any such transfer shall cause the annulment of the contract so far as the United States are concerned. All rights of action, however, to recover for any breech of this contract by the said party of the first part are reserved to the United States.

7th. No member or delegate to Congress, nor any person belonging to, or employed in, the military service of the United States, is

or shall be admitted to any share or part of this contract, or to any benefit which may arise herefrom.

KRAG-JÖRGENSENS GEVAERKOMPAGNI, [SEAL.]
By F. PETERSON, *Attorney*, [SEAL.]
D. W. FLAGLER, [SEAL.]
Brig. General, Chief of Ordnance.

Witnesses:
E. A. SKILLMAN.
WINFIELD S. CLARKE.

26 II.—*Demurrer. Filed March* 17, 1899.

ANDREW H. RUSSELL and WILLIAM R. LIVERMORE
vs.
THE UNITED STATES. } No. 20833.

And now come the said defendants, by their Attorney General, and demurring to the amended petition in this cause, state as the ground thereof that the petition does not allege facts sufficient to constitute a cause of action.

L. A. PRADT,
Assistant Attorney General.

27 III.—*Opinion of the Court.*

RUSSELL AND LIVERMORE
v.
THE UNITED STATES.

On demurrer.

DAVIS, J., delivered the opinion of the court:

The question presented by the demurrer is whether the facts pleaded show an implied contract between these parties for the use by the defendants of plaintiffs' alleged patented invention for a military rifle.

After allegations as to the issue of patent, not at this moment important, plaintiffs state, in substance, that to an army board organized to select a magazine rifle they submitted one invented by them; this also to another army board and to other army officers. The second board named in the petition recommended the adoption by defendants of the Krag-Jörgensen device, herein termed the "Army rifle;" this about September 15, 1892. Some two months later one of the plaintiffs wrote the chief of ordnance of the army stating (we quote from the petition), "that the inventions described in and protected by the said letters patent No. 230,823 were embraced, embodied, and included in the said Army rifle," and requested the "chief of ordnance to make provision for the payment of compensation to these claimants by the United States for the use of said patent in the proposed manufacture of the said 'Army rifles.'"

To this was replied by defendants that their business with the Krag-Jörgensen Company had not been completed; that this com-

pany might agree to indemnify defendants herein for loss incurred by the use of the Army rifles, "and thereby the claimants would be provided with a remedy to be obtained from the said Krag-Jörgensen Geværkompagni, or the Government might proceed to manufacture the said 'Army rifles' without such an arrangement, in which case the claimants could obtain their remedy by suit against the United States in the Court of Claims after the manufacture had progressed."

December 9, 1892, plaintiffs wrote the chief of ordnance that they could recover nothing from the Krag-Jörgensens, a foreign corporation, and again asked compensation. To this the chief of ordnance answered, suggesting an application to the Patent Office. This application was made with a claim that the Army rifle contained plaintiffs' devices. The Commissioner of Patents "declined to exercise any jurisdiction over the said claim." Later (July 7, 1893), the Ordnance Department informed plaintiffs (after advising a statement of their case in writing) that an agreement had been made with the Krag-Jörgensen Company "whereby (we still quote the petition) the latter was required to indemnify the United States against all damages for infringements of patent rights which might arise in the manufacture of the said Army rifle."

28 An answer (November 22, 1893) was sent to this communication, stating plaintiffs' position, following which (December 1, 1893) the Ordnance Department cited to plaintiffs this said clause in the Krag-Jörgensen agreement (Exhibit E to petition):

"The said party of the first part (the Krag-Jörgensen Company) shall indemnify the United States and all persons acting under them for all liability on account of any patent rights granted by the United States which may affect the right to manufacture herein contracted for." The Ordnance Bureau added that these plaintiffs' claims could not be determined by that bureau.

The petition further states that General Flagler (chief of ordnance) contracted with the Krag-Jörgensens for "an unlimited number of the said Army rifle," they (Krag-Jörgensen) claiming their invention to be sufficiently protected by patent.

The penalty of the Krag-Jörgensen's bond to defendants was to be "to protect and defend the United States against all suits and claims by any and all persons for its infringement of their inventions in the manufacture of the said Army rifle, and to pay all judgments that might be obtained against the United States for the same"

The petition further alleges defendants' use of Krag-Jörgensen rifles, the payment to that company of royalties, and then comes therein this statement: "But the Krag-Jörgensen Company then failed to furnish a bond to indemnify the United States as in the said contract provided, and the United States, for its indemnity and in lieu of such bond, did from time to time, prior to June 16, 1896, with the consent of the Krag-Jörgensen Company, withhold sums payable on account of the said royalties," which amounted to a certain sum.

Finally plaintiffs, in substance, allege that certain Army rifles

manufactured and used by defendants included their inventions (patent 230,823)—inventions not protected by the Krag-Jörgensen patent.

Such is the abstract of the petition through which plaintiffs seek to recover from defendants a royalty for use of a patented device. This recovery they cannot have unless they show a contract, express or implied, between the parties to this action. Therefore, without inquiring as to the validity of the plaintiffs' patent, we look to the petition alone (the hearing is on demurrer) to see what allegations therein appear showing such "a meeting of the minds" upon this matter as may make a contract. We find therein pleaded a submission of plaintiffs' device to defendants' army board, and the adoption by defendants of another device; then a demand made by plaintiffs upon defendants for compensation, urging that their "inventions" (theretofore patented) were in the new Army rifle. Defendants, however, declined all responsibility in the matter, and referred plaintiffs to the Krag-Jörgensens for remedy or to this court, saying that their (defendants') "business with the Krag-Jörgensen Company had not been completed."

Later, in response to plaintiffs' statement that they could recover nothing from the Krag-Jörgensens, the chief of ordnance advised an application to the Patent Office, and again later they were informed of the Krag-Jörgensen bond "to indemnify the United States against all damages for infringement of patent rights which might arise in the manufacture of the said Army rifle."

29 There is nothing in these facts to show that the defendants through their officers entered into or intended to enter into any contract with plaintiffs. The first answer plaintiffs received from the Department of War (Exhibit B) stated that "business arrangements with the Krag-Jörgensen Company for the manufacture of this arm have not yet been completed. * * * That company may agree to indemnify the United States on account of any patent rights granted by the United States which may affect the manufacture of the guns, in which case your recourse would be to communicate directly with the company.

"On the other hand, should the Government proceed to manufacture the arms without such arrangement, your course will be to bring a suit against the Government in the Court of Claims after manufacture has progressed."

The Patent Office denied jurisdiction; the Ordnance Office said they could not determine the case.

In Schillinger's case (24 C. Cls. R., 278) this court held, after a review of the authorities: "A careful examination of these cases shows that a contract to pay is implied whenever the Government, acting through a competent agent, takes or uses individual property, acknowledging explicitly or tacitly that the property is individual property." (Affirmed by the Supreme Court, 155 U. S. R., 163. See also Berdan's case, 25 C. Cls. R., 355; 26 *ib.*, 48; 30 *ib.*, 491, and cases cited. Affirmed by the Supreme Court, 156 U. S. R., 552.)

In brief, it appears from the petition that the chief of ordnance informed plaintiffs that the Krag-Jörgensen Company, with whom

he had not finished his negotiation, might agree to indemnify them "for losses incurred in the use of the Army rifle, whereby plaintiffs would have a remedy against that company, or the Government might proceed to manufacture 'the said Army rifle,' without an agreement of indemnity for infringement from the Krag-Jörgensens, when plaintiffs would find a remedy in this court." Later another letter to plaintiffs threw all responsibility on the Krag-Jörgensen Company.

Some effort is made to establish a right in plaintiffs through the Krag-Jörgensen bond to the Government. This bond was given to defendants to indemnify them in case of successful action for infringement arising from use of the Krag-Jörgensen device. There are no rights whatever secured to plaintiffs by this bond. They are not privy to it.

Upon the whole case it appears that the Government at no moment recognized any rights in plaintiffs against it or any responsibility upon its part to them. Quite the contrary. Defendants took an indemnity bond from the Krag-Jörgensens and threw all responsibility for conflicting claims upon them. The case falls within the principle of that of Schillinger. No contract is developed by the allegations of the petition. It is therefore ordered dismissed.

30 IV.—*Judgment of the Court.*

ANDREW H. RUSSELL and WILLIAM R. LIVERMORE
vs.
THE UNITED STATES. } No. 20883.

At a Court of Claims held in the city of Washington on the 26th day of February, 1900, judgment was ordered to be entered as follows:

It is ordered that the demurrer of the defendants be sustained, and it is further ordered, adjudged, and decreed that the petition of the claimants be dismissed.

BY THE COURT.

31 V.—*Application for and Allowance of Appeal.*

ANDREW H. RUSSELL and WILLIAM R. LIVERMORE
vs.
UNITED STATES. } No. 20883.

Now come the claimants, Andrew H. Russell and William R. Livermore, by McCammon and Hayden, their attorneys, and pray the court to allow them an appeal to the Supreme Court of the United States from the judgment of this court, entered in the above-entitled cause on the 26th day of February, 1900.

McCAMMON & HAYDEN,
Att'ys for Claimants.

Filed February 28, 1900.

MARCH 20, 1900.

Ordered that the foregoing application for appeal be allowed as prayed for.

BY THE COURT.

32 Court of Claims.

ANDREW H. RUSSELL and WILLIAM R. LIVERMORE
vs.
THE UNITED STATES. } No. 20883.

I, John Randolph, assistant clerk Court of Claims, hereby certify that the foregoing are true transcripts of pleadings, opinion of the court, judgment of the court, application for and allowance of appeal to the Supreme Court of the United States.

Seal Court of Claims.

In testimony whereof I have hereunto set my hand and affixed the seal of said Court of Claims this 2d day of April, A. D. 1900.

JOHN RANDOLPH,
Ass't Clerk Ct. of Claims.

Endorsed on cover: File No., 17,704. Court of Claims. Term No., 242. Andrew H. Russell and William R. Livermore, appellants, *vs.* The United States. Filed April 5th, 1900.

No. 242.

Brief of McCammon

Office Supreme Court U. S.
FILED
MAR 19 1901
Clerk.

for Appt.

Filed Mar. 19, 1901.

Supreme Court of the United States.

OCTOBER TERM, 1900.

No. 242.

ANDREW H. RUSSELL, ET AL., APPELLANTS,

vs.

THE UNITED STATES.

Appeal From the Court of Claims.

BRIEF FOR THE APPELLANTS.

JOS. K. McCAMMON,
JAMES H. HAYDEN,
Of Counsel for the Appellants.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1900.

ANDREW H. RUSSELL ET AL., APPELLANTS,

v.

THE UNITED STATES.

No. 242.

BRIEF FOR THE APPELLANTS.

STATEMENT OF THE CASE.

This is an appeal from the judgment of the Court of Claims by which the defendant's demurrer was sustained and the petition dismissed (p. 19).

The claimants are seeking to recover compensation for the use of their patented invention, by the United States.

There was no express contract, but the claim is founded upon a contract to be implied from the transactions of the parties and the circumstances under which the use of the invention was made. In compliance with a rule of the Court of Claims,* these transactions were fully set

*Rules, Court of Claims, 16, p. 6:

"If it (the claim) be founded upon an implied contract, the facts upon which the claimant relies to prove a contract, must be specified."

forth in the petition (pp. 1–16). By demurrer the United States contended that the facts did not constitute a cause of action (p. 16).

These are the facts relied upon :

Prior to and throughout the period covered by the transactions in question, the claimants were the owners of United States letters patent, No. 230,823. This patent had been granted to the claimant Russell for his invention of an improvement in magazine fire-arms (p. 1).

In 1881, a Board of Army officers was convened to test magazine rifles, having in view the adoption of one for the use of the Army. The board was under no obligation to adopt any of the rifles tested by it, and was at liberty to adopt one embodying features of two or more devices. An advertisement was published, by which inventors and patentees were invited to present their rifles to the board. Among those who responded to this invitation were the claimants, who presented two rifles. These were somewhat different in design, but both embodied the inventions described in the claimants' patent. No rifle was adopted at that time (pp. 1–2).

In 1890 a similar board was convened. To it the claimants presented among others the rifles which they had presented to the board of 1881. They were not tested or reported upon, because their calibre differed from that desired by the Army in 1890, but their mechanisms were fully explained to the board by the claimant Russell (pp. 1–2). Among others, the Krag-Jorgensen Gevaerkompagni of Christiania, Norway, presented a rifle to the board of 1890. It was provisionally adopted for the military service about September 15, 1892. Certain features covered by the claimants' patent which were embodied in the rifles presented by them in 1881 and again in 1890 were also embodied in the Krag-Jorgensen model (p. 2)

On November 16, 1892, the claimants wrote to the Bureau of Ordnance, saying that these features of the Krag-Jorgensen model, were covered by their patent, and were not protected by the later patents owned by the Krag-Jorgensen Gevaerkompagni; wherefore the claimants asked that, in awarding royalties for the use of patented inventions embodied in the rifle adopted the Bureau consider their patent and provide for their compensation (pp. 2, 6–7).

On November 18, 1892, the Bureau of Ordnance replied: It did not deny the validity of the claimants' patent, or the fact that their invention was embodied in the device adopted, and did not refuse to regard their patent or to provide for their compensation. It advised them that no "business arrangements" had been made with the Krag-Jorgensen Gevaerkompagni. It assured the claimants that one of two things would be done. Either the company would indemnify the United States in such a manner that the claimants would be provided with a remedy to be obtained from the company, or else, the United States would proceed to manufacture without such an arrangement; in which event the claimants' remedy would be "*to bring suit in the Court of Claims after the manufacture had progressed*" (pp. 2, 7).

Further correspondence followed between the claimants and the Bureau of Ordnance, which in no way changed their status (pp. 2–3, 7–9).

Finally, on July 7, 1893, the Bureau of Ordnance requested the claimants to present a full and explicit statement of their claim, in writing, to be filed for future reference, because the matter was not one that could be determined by the Bureau (pp. 3, 15). In compliance with this request, the claimants furnished a statement of their claim, which was filed in the Bureau "for future reference" (pp. 3, 10–13).

On June 7, 1893, the Krag-Jorgensen Gevaerkompagni entered into a contract with the United States. The company thereby licensed the United States to manufacture and use an unlimited number of rifles of the design which had been adopted, as above related. The company warranted that its patents fully covered all portions of the device not open to public use. The United States agreed to pay a royalty upon each rifle manufactured. It was further agreed that before any royalties were paid the company it should furnish a bond in the sum of $25,000, conditioned for the indemnification of the United States against all suits and claims, by any persons, for the infringement of their patents in the manufacture of the rifles, and for the payment of all judgments which might be obtained against the United States on that account (pp. 3–4, 14–16).

Thereafter the United States proceeded with the manufacture of the rifles. They were first introduced for service in the Army about January 1, 1894 (p. 4). Between that day and that of the commencement of this suit upwards of 75,000 of them were manufactured and used by the United States (p. 5).

As the manufacture progressed, the United States accounted to the Krag-Jorgensen Gevaerkompagni for royalties, but the company failing to give bond as required by the contract, the United States, with the company's consent, from time to time, retained sums for its indemnity, which otherwise would have been payable to the company as royalty. On June 16, 1896, the Krag-Jorgensen Gevaerkompagni furnished a bond which was accepted by the United States, and all moneys theretofore withheld were paid over to the company. The condition of the bond was that, having licensed the United States to manufacture an unlimited number of Krag-Jorgensen rifles, under

the company's patents, the company would indemnify the United States and its agents on account of patent rights granted by the United States which might affect their right to manufacture the rifle, and would defend the United States against suits and claims for the infringement of such patent rights and pay all judgments obtained therein against the United States (pp. 4–5).

The United States has paid the claimants nothing, although due demand has been made (p. 6).

Specifications of Error.

The errors of the Court of Claims assigned by the appellants and intended to be urged are these:

1. The said Court erred in sustaining the defendant's demurrer.

2. The said Court erred in dismissing the petition.

3. The said Court erred in ruling that the petition did not allege facts sufficient to constitute a cause of Action.

Argument.

Recent decisions of this Court and of the Court of Claims made it incumbent upon the claimants to establish a contract, by which the United States agreed to allow them such reasonable compensation as might become due them for the use which it had made of their property. We submit that such a contract is to be implied from the facts just stated.

It cannot be considered that the military board invited inventors to present their devices with the intention of defrauding or injuring them. On the contrary, the implication arises that the United States intended to pay any inventor who offered his property and whose property was

subsequently taken. The claimants, in 1881, offered their patented invention, or its embodiment, in the form of two rifles. To be sure, neither of these was adopted by the board of 1881; but neither was the entire mechanism of either condemned. In 1892, the same rifles were presented to the second military board, and their mechanism was fully explained, and the board knew that the claimant Russell had obtained a patent upon the various inventions embodied in the rifles. Neither of these rifles was tested by the board or reported upon, because they were not of the prevailing calibre (Report of the Chief of Ordnance, 1892, p. 155), but the difference in the bore of the barrels certainly did not prevent the board from observing the breech mechanisms and the magazines. The board of 1892 recommended the adoption of the rifle presented by the Krag-Jorgensen Co. It did not assume to say that the device was novel, or that it did not infringe the claimants' patent, or any one else's patent. The rifle was recommended as an entirety because it worked to the satisfaction of the board. The board was not competent to pass upon such questions and did not do so.

On November 16, 1892, the claimants having learned that the Krag-Jorgensen rifle was to be adopted for the military service, wrote to the Chief of Ordnance, saying (Ex. A, pp. 6, 7), that a part of its mechanism embodied inventions described in and protected by their patent. They did not forbid the United States to use their invention, or say that its use by the United States would be a violation of their rights. They tacitly assented to such use, and merely requested the United States to allow them reasonable compensation (pp. 2, 6–7, Exhibit A). It cannot be denied that by these acts the claimants offered the United States the right to use their inventions, and that it was understood by the Ordnance Bureau that the claimants ex-

pected to be paid reasonable compensation for any such use.

On November 18, 1892, the Chief of Ordnance replied to the claimants' letter of the sixteenth. He said that the Government had not completed its arrangements for the manufacture of the rifle adopted; that these arrangements, when completed, might provide the claimants with a means of getting their compensation from the Krag-Jorgensen Co.; or, that the claimants might obtain any compensation to which they became entitled, by a suit to be brought in the Court of Claims after the manufacture had progressed—in other words, might sue the United States in an action of assumpsit. (Ex. B, p. 7.)

It appears that the Government did not adopt the first alternative and provide the claimants with a means of obtaining compensation from the Krag-Jorgensen Co. The bond of indemnity given by the company to the United States is so worded that only the United States could sue upon it. It is to be presumed that the second,—the only remaining alternative,—was adopted.

This was not a rejection of the claimants' offer. There was no ambiguity either in the Bureau's letter or the course pursued by the United States. To be sure the letter did not contain a positive agreement to pay the claimants a definite royalty; but we are not called upon to prove an express contract. The letter was a conditional acceptance, saying that the United States would pay or would see that the claimants were paid for the use of their invention, provided that such a use were made.

The correspondence which ensued between the claimants and the Chief of Ordnance shows that such was the intention of the United States. If this had not been so, and the Government had not intended to recognize the claimants' rights, or even to maintain an attitude of neu-

trality toward them, why did the Chief of Ordnance ask the claimants for a detailed statement of their case "for future reference"? Why did not the Chief of Ordnance advise the claimants that the Government did not wish to deal with them, instead of saying, "The case cannot be determined by the Ordnance Department"? (p. 10, Exhibit H). Why did the United States, which is not and never has been held liable to suit in actions sounding in tort, require the Krag-Jorgensen Co. to indemnify it against liability on account of judgments obtained for the use of patent rights, which might affect the right of the United States to manufacture rifles of the so-called Krag-Jorgensen type? (pp. 3–4 and 14–16).

In the court below the defense contended that the Chief of Ordnance did not intend to accept the claimants' offer, and probably wrote as he did because he did not know that the United States could not be sued in actions sounding in tort. That is a preposterous proposition. The general jurisdiction of the Court of Claims in 1892, was governed as it has been since March 3, 1887, and as it is now, by the Tucker Act, and earlier statutes. These statutes had been passed upon by this Court in similar cases. All persons, even Government officials, are presumed to know the law, and their actions are to be interpreted in accordance with that presumption.

The petition is clear in showing that after the above correspondence had passed between the claimants and the Chief of Ordnance, the United States proceeded to manufacture and use in its military service large numbers of the rifles embodying the invention described in the claimants' patent. This act fulfilled the condition of the Government's acceptance of the claimants' offer.

Hence we have established the essential elements of a contract: Proper parties; proper subject-matter; an offer;

a conditional acceptance, and the fulfilment of that condition.

The claimants are here seeking an adjustment of their compensation as proposed by the Chief of Ordnance in his letter of November 18, 1892 (Exhibit B, p. 7).

In many cases, where the ultimate facts were practically identical with those under discussion, this Court and the Court of Claims have held that the claimant was entitled to recover as upon an implied contract.

In the case of *Butler* v. *United States* (23 *Ct. Cl.* 335), the Court of Claims found as a fact that the custom of the Bureau of Ordnance with respect to the adoption and use of patented inventions, was this:

> "Needed improvements in the service arms are suggested or developed during the progress of manufacture by officers of the Ordnance Department, and often by officers of the line of the army after actual trials in the hands of troops. The changes thus suggested, if promising, are put on a few arms, and after extended and thorough trials at the place of manufacture to prove their utility, a number are made, embracing the changes suggested, for experimental purposes, and placed in the hands of troops for actual trial, and in the event of such trials proving satisfactory the changes are adopted and put on all arms issued to the service. Needed improvements have been added from time to time, regardless of the fact that the same may be *infringement* of patent rights." (Finding V, p. 337.)

It appeared that Butler offered the use of his patented invention to the Government. The War Department did not procure a license from or hold any communication with him. The Government manufactured and used devices embodying the invention. The court gave judgment for the claimant in a sum which it fixed upon as reasonable compensation for the use of the invention. It was said:

> "The liability of the Government in this case arises exclusively from its own acts."

Here, then, a contract was implied from nothing more than a neutral absorption and beneficial use of the claimant's property by the United States. In the case at bar the petition alleges more than this. Positive acts were done by the claimants as well as by the Government. There was a tender by the claimants, a promise by the Government that the claimants' rights in the premises should be protected, either by right of action against the United States in the Court of Claims, or by indemnity to be taken for their benefit by the United States, and thereafter a beneficial use by the Government of the claimants' property.

In the case of *Berdan Fire Arms Manufacturing Co.* v. *United States*, this Court and the Court of Claims found that the custom of the Bureau of Ordnance was this:

> "The War Department is early and regularly informed of all improvements and inventions in fire-arms and ammunition. It is aware of the state of the art at all times, and generally knows of all patents upon fire-arms as soon as issued. *The attitude of the War Department towards inventors in ordnance has been one of neutrality; it has neither denied nor admitted the legal rights, if any there were, of inventors; in an endeavor to perfect the Government arm, that Department has taken advantage of all knowledge within its reach and of all inventions; it does not deny the claims of inventors, but has proceeded upon the policy that executive officers should not decide upon such claims against the Government or upon conflicting claims; but that the claims should be presented, without prejudice, before some other tribunal than an executive department.*"
>
> 156 *U. S.* 552, 558.
> 26 *Ct. Cls.* 48, 60.

It appeared that Berdar presented his device to a board of Army officers, and urged its adoption. The officers of the Ordnance Department were acquainted with Berdan's inventions and knew that he had patented them. The parties were in constant communication and Berdan gave notice that he should expect compensation for the use of his inventions. General Benét, who became Chief of Ordnance some time after the manufacture of the Government's device began, believed that it was identical with, or the mechanical equivalent of that patented by Berdan. He proceeded with the manufacture, believing that, if his opinion of the device were correct, "the Government would pay for the use of the invention through the instrumentality of the courts."

It was said (26 *Ct. Cls., pp.* 78–79):

> "We find then, in these facts, a tender of the device to the Government, and a use of the device knowingly in the belief that the Government would be called on to pay royalty for the device, provided the understanding of the Chief of Ordnance was correct—that is, provided the Government was doing what he believed they were doing—manufacturing and using plaintiff's device or its mechanical equivalent.
>
> "The use by the Government was not a mistaken use, for the Chief of Ordnance understood he was doing what we have decided he was doing, to wit, using plaintiff's device. It was not an unauthorized use, for the Chief of Ordnance has a very broad power in matters of this description (R. S. U. S., Sec. 1164). It was not a use in ignorance, for the Chief of Ordnance was fully informed of all the facts; it was not an antagonistic use, for plaintiffs were anxious that defendants should adopt and use their devices.
>
> "The only element of doubt seems to have been whether the ordnance officers should decide finally

what they believed to be true, that plaintiffs were entitled to compensation, or whether they should leave that matter to the courts or to some other competent authority. We are of opinion that under the rulings of the Supreme Court and of this court, heretofore cited, the facts disclose a contract between the parties to this action, for the use of the extractor-ejector device."

At the hearing of the present case in the court below, the defense contended that the custom of the Bureau of Ordnance, under which it preserved toward all patentees an attitude of neutrality, had been abandoned, and that after the decisions were rendered in the cases of *Butler* v. *U. S.*, and *Berdan Co.* v. *U. S.*, the Bureau concluded to regulate such matters for itself, without enlightenment from the courts and without regard to the rights of inventors. In other words, that the Bureau decided to take whatever it pleased, and pay whomsoever it pleased.

The transactions of the parties, set out in the petition, do not disclose such an intention on the part of the Bureau of Ordnance. If such had indeed been its intention, it would not have amounted to a change of custom, for a custom must not violate the law; it cannot be unreasonable; and it cannot be established by the undisclosed wishes of one party. We submit that the custom of the War Department as found in the cases cited must be taken as a guide, in the decision of this case.

A most thorough and scientific consideration of the liability of the Government to compensate patentees for the use of their inventions is contained in the opinion of the Court of Claims in the case of *McKeever* v. *United States* (14 Ct. Cl. 396). McKeever, an officer of the Army, was the owner of two patents for improvements in mili-

tary equipment. He presented his devices to a board of Army officers, through the Chief of Ordnance. The board recommended the adoption of the device, and this was approved by the Secretary of War. The board believed that in adopting McKeever's device, the Government would not be liable for royalty; but this was not stated in their report, nor communicated to McKeever. McKeever made inquiry of the Chief of Ordnance, concerning the adoption of his device, saying:

"It is a matter of interest to me."

He was informed that the device had been adopted, but that it would be used to a very limited extent. Thereafter, McKeever asked that the devices manufactured be marked "Patented," in accordance with the Act of July 8, 1870. This the Chief of Ordnance refused to do. In one respect, McKeever's invention was anticipated by a patent of earlier date. The defense maintained, among other things, that if McKeever had any rights in the premises, he could maintain an action against the officers of the United States, who had *infringed* his patent, and that "there could be no waiver of the tort so as to give the court jurisdiction." The court held that under the Constitution and laws of the United States, the property rights of a patentee in his invention are to be treated in no other way than those of the owner of other property. It was said (pp. 423-424):

> "The counsel for the defendant also insists that the action of the Government in resorting to the claimant's invention was either a tort or a user under gratuitous license from him. We are unable to adopt either of these extreme views. When a vendible article, such as ordinarily is the subject of bargain and sale, is offered by a producer to a consumer, though with no price specified, and is accepted and

used by the latter, it is not to be supposed, on the one hand, that the offer was intended as a gift *inter vivos*, nor implied on the other that the taking was with tortious intent."

. . . . . .

"If the Quartermaster General had appointed a board to select a wood lot for the fuel of the army, and a farmer had written to him recommending his wood, and the board had reported in favor of it, and the Quartermaster Department had proceeded to cut and use the wood, can it be supposed that this would be deemed a tortious taking on the part of the Quartermaster General, or a gratuitous license on the part of the farmer? Yet this is a mere paraphrase of the facts in this case. The claimant had gone to the expense of turning his invention into property; it was an article salable almost exclusively to the Government; his offer imported a desire to sell to almost the only purchaser of such articles; the defendant's officers considered and acted upon his offer, and adopted and used his design. If they proceeded and he allowed them to proceed without the formality of an express license or the precaution of an express consideration, the omission did not change the character of the transaction, for the law supplies by implication a price in giving what the license was reasonably worth."

The judgment of the Court of Claims was affirmed on appeal, by this Court, without an opinion (*McKeever* v. *U. S.* 18 *Ct. Cls.* 757–758).

Certainly the petition in the case at bar recites facts from which a contractual status may be implied quite as clearly as from those found in McKeever's case. The correspondence of the parties differs only in this: that McKeever did not actually claim compensation before the United States proceeded to use his invention. Russell and Livermore did claim compensation. The Chief of the

Bureau of Ordnance did not promise McKeever compensation. To Russell and Livermore he did promise that they would have an opportunity to show whether their property was taken, and upon doing so would be paid for it.

In such a case as this the position of the United States is not the same as that of an individual who has used another's patent. In its opinion in the case of *Kelton* v. *U. S.* (32 *Ct. Cls.* 314–341), the Court of Claims said:

> "McKeever's (14 Ct. Cl. 396) is the leading case of actions brought on implied contract to recover for the use of an invention; the first case *where an inventor recovered for what, as between individuals, would be an infringement of his patented device.*"

The Government, then, is not to be presumed guilty of wrong in all cases where it might be imputed to an individual. Where the Government has been paid the lawful fees for granting a patent, and has granted it, and the use of the invention patented has been offered the Government, at its request, and the Government has recognized the proprietary rights of the patentee, conditionally or unconditionally, and thereafter has made beneficial use of the invention, the Government's course is presumed to have been actuated by honest, not dishonest, motives. It is presumed that the Government intended and agreed to pay for what it enjoyed, rather than that it took what it pleased regardless of individual rights, and in violation of Article V of the Amendments to the Constitution.

There are other pertinent and valuable authorities among the opinions of this Court. We cite them without discussion, because they are well known.

United States v. *Burns*, 12 *Wallace*, 246.
Cammeyer v. *Newton*, 94 *U. S.* 225.
United States v. *Palmer*, 128 *U. S.* 262.

The Government will undoubtedly rely upon the decisions in the case of *Schillinger v. United States* (24 *Ct. Cls.* 278), and (155 *U. S.* 163). In these, it appeared, either that there had been a mere naked use by the United States of an invention, without presentation by the owner, and without recognition by the United States, conditional or unconditional; or else that there had been an outright infringement, accompanied by a denial of the use. In such cases the petitions were dismissed because the Court of Claims had not jurisdiction in causes sounding in tort. We submit that these are not pertinent authorities.

The Government may endeavor to make capital out of the occurrence of the words "infringed" and "infringement," in the correspondence between the claimant Russell and the Bureau of Ordnance. In each instance where one of these words is found, it was used to describe the rifle manufactured by the Krag-Jorgensen Gevaerkompagni and presented to the board of 1892. No such term was applied to the prospective use of the claimants' invention by the United States. Even if this very technical defense had some foundation in fact, which it has not, the purport of the correspondence is too plain to permit the loose expressions of a layman to distort it. The first letter of the Chief of Ordnance, wherein he recognized the claimants' rights (pp. 2, 7), shows clearly that the Government had no intention of infringing the claimants' patent. That letter promised that, if the patents were "*used*" (p. 7), such use would be paid for upon the claimants' making proof of the use, in a suit to be brought in the Court of Claims. The claimants never protested against the use of their invention, but invited it. They never expressed dissatisfaction with the Government's suggestion that they could "bring suit in the Court of

Claims after manufacture had progressed" (p. 11). They objected to nothing except being left to seek an impossible "remedy for infringement" of their "patent against the Krag-Jorgensen Company," which had no intention of engaging in the manufacture of rifles, and hence would not use the claimants' patent, and which was a foreign corporation utterly irresponsible and inaccessible to the process of the courts of the United States.

We submit that the petition states a cause of action founded upon an implied contract, and that the judgment of the Court of Claims should be reversed.

JOS. K. McCAMMON,
JAMES H. HAYDEN,
Of Counsel for the Appellants.

[redacted]

In the Supreme Court of the United States.

OCTOBER TERM, 1900.

ANDREW H. RUSSELL AND WILLIAM R. Livermore, appellants, *v.* THE UNITED STATES. } No. 242.

APPEAL FROM THE COURT OF CLAIMS.

BRIEF FOR THE UNITED STATES.

STATEMENT OF THE CASE.

On August 3, 1880, United States Letters Patent No. 230823, were granted to the appellant Russell, for certain improvements in breech-loading guns. In 1882 he submitted three samples of his patented gun, differing from each other in minor details only, to a board of officers convened under the act of February 24, 1881, § 1 (21 Stats., 346, 349), to select a magazine rifle for the United States Army. These guns were tested, but worked with difficulty. The board selected three types of guns, submitted by other parties, for trial in the hands of troops, but no final adoption of any type of gun was made at that time. (Rec.

1; Ho. Ex. Doc. No. 1, 47th Cong., 2d sess., pt. 2, vol. 3, pp. 329 et seq.) On February 4, 1891, the appellant Russell assigned a half interest in his patent to the appellant Livermore, and on January 22, 1892, the appellants again submitted the three above-mentioned guns of their patented type to a board of officers, convened by direction of the Secretary of War for the same purpose as the former board. No test was made of these guns, as they were neither of the caliber desired by the board, nor in proper condition, but the appellant Russell explained their operation to the board. (Report of Chief of Ordnance, 1892, p. 155.) On September 15, 1892, the second board recommended the adoption of a gun submitted by the Krag-Jörgensen Geværkompagni, of Christiania, Norway, and it was provisionally adopted by the War Department as the army rifle. (Rec., 2.)

On November 16, 1892, the appellant Russell, in behalf of both the appellants, wrote to the Chief of Ordnance that they believed that the Krag-Jörgensen gun infringed their patent in certain particulars, and requested that "in considering the allowance to inventors" their "claims for these vital points of construction be regarded." (Rec., 6–7.) In reply the Chief of Ordnance stated:

> * * * The business arrangements with the Krag-Jörgensen Company for the manufacture of this arm have not yet been completed.
>
> On the one hand, that company may agree to indemnify the United States on account of any patent rights granted by the United States

> which may affect the manufacture of the guns, in which case your recourse would be to communicate directly with the company.
>
> On the other hand, should the Government proceed to manufacture the arms without such arrangement, your course will be to bring a suit against the Government in the Court of Claims after the manufacture has progressed. (Rec., 7.)

Russell then wrote, December 9, 1892, that as the Krag-Jörgensen Company had no property in this country there was no practical remedy against it for an infringement, and that he therefore requested a hearing before any business arrangement with the company was closed. (Rec., 7–8.) The Chief of Ordnance replied that the Commissioner of Patents had stated that the Krag-Jörgensen invention had been found to be patentable, but that as other pending applications seemed to be in conflict with it, the patent would not issue until the questions raised were decided. It was therefore suggested that Russell communicate directly with the Commissioner. (Rec., 8.) Russell did so, but the Commissioner replied, on February 14, 1893, that he had no jurisdiction in the matter, as questions of infringement could be determined only by the courts. (Rec., 9.)

On June 7, 1893, the Chief of Ordnance, by authority of the Secretary of War and in his behalf, contracted with the Krag-Jörgensen Company for the right to manufacture an unlimited number of the Krag-Jörgensen guns, for a royalty of $1 per gun. The

contract stated that the company claimed that the Krag-Jörgensen patents fully cover all the mechanism of the gun not open to public use, and provided that a bond should be given to protect and defend the United States against all suits and claims on account of infringement of inventions in the manufacture of these guns. (Rec., 14–16.) On June 30, 1893, Russell wrote to the Chief of Ordnance informing him of what the Commissioner of Patents had written on February 14, 1893, adding that the construction of the Krag-Jörgensen gun infringed the appellants' patent, although the Krag-Jörgensen patents did not. (Rec., 9.) The Chief of Ordnance then asked Russell for a written statement of his case, adding that the Krag-Jörgensen Company were required to guarantee the United States against all damages for infringement. Russell then stated his case in writing, pointing out the particular matters as to which he claimed that the appellants' patent was infringed by the Krag-Jörgensen gun. (Rec., 10–13.) The Chief of Ordnance replied on December 1, 1893, stating that the Ordnance Office could not determine the case, and calling Russell's attention to the following clause in the contract of June 7, 1893:

> The said party of the first part shall indemnify the United States and all persons acting under them for all liability on account of any patent rights granted by the United States which may affect the right to manufacture herein contracted for.

The same letter continued as follows:

> You have requested that a copy of your communication and a copy of your patent should be forwarded by this office to the company, and for that purpose you have forwarded duplicates of your letter and of the patent specifications. It is considered best that you should forward these communications direct; they are, therefore, returned to you for the purpose. (Rec., 14.)

On September 18, 1897, the appellants filed their petition in the Court of Claims, and later an amended petition, setting up the facts above stated. On demurrer the amended petition was dismissed February 26, 1900, whereupon this appeal was taken. (Rec., 1, 19, 20.)

BRIEF OF ARGUMENT.

As far as concerns the form of the pleadings, the only difference between the present case and that of *Schillinger* v. *United States* (155 U. S., 163) is that in the latter case the petition set up, in terms, a "wrongful appropriation" of a patented invention by the United States, whereas here the petition sets up certain facts, including the correspondence between the parties, and then states that a contract "is to be implied from the use by the United States of the claimants' said patented invention, as hereinbefore related." While such argumentative pleading would have been bad at common law, it complies with rule 16 of the Court of Claims, providing that "if [the claim] be founded upon an implied contract, the facts upon

which the claimant relies to prove a contract must be specified." The object of this rule is obviously to enable the court to see whether or not a contract can be implied from the facts alleged, in case they are proved, and the argumentative allegation that a contract is to be implied might really as well be omitted, except for its possible use in directing the court's attention to the fact that the suit is brought upon the theory of an implied contract and nothing else.

At all events, the allegation of an implied contract is purely argumentative, and in no way prevents either the defendant from demurring on the ground that the facts are not such as to warrant the implication of a contract, or the court from considering the allegations of fact and deciding whether or not a contract can really be implied from them. In the present case the court below has decided that a contract can not be implied.

The difference between the present case and the *Schillinger* case as to the form of the pleadings is, however, unimportant, because the decision in the *Schillinger* case was not based upon the circumstance that the petition set up, in express terms, a "wrongful appropriation" of the claimants' patented invention, but upon the much more important circumstance that "the transaction as stated in the petition, and as disclosed by the findings of the court, was a tort pure and simple." In other words, had the petition in the *Schillinger* case merely recited the facts, concluding with an averment that a contract was to be implied from those

facts, and had the same facts appeared in the findings of the court below, the decision would have been just the same. The gist of the decision was that the case was essentially a case "sounding in tort," and not that the claimant had undertaken to sue in tort instead of in contract. Hence, if in the present case the court below was right in holding that the facts alleged in the petition show that the transaction was a tort, the mere fact that the appellants have attempted to sue in contract will not prevent the *Schillinger* case from being a conclusive authority against them.

It is submitted that the statements of fact in the amended petition do not warrant the implication of any contract between the appellants and the appellee. A contract involves an offer and an acceptance. If the submission of the appellants' gun to the board of officers in 1882 constituted on offer, there was certainly no acceptance, for the board's report was wholly adverse to the gun submitted. Three samples of this gun appear to have been submitted, differing from each other in minor details only. As to the first, called No. 14, the report is as follows:

> Four hundred shots were fired; 33 missfires; 6 failures to eject. After firing 100 shots the exhibitor was permitted to replace the ejector with a new one. In the fourth 50 of shots the bolt twice pulled entirely out to the rear in opening, caused by the sear spring failing to press the sear into the notch. After 400 shots the gun worked with great difficulty, and on inspection was decided to have broken down, and was withdrawn.

As to the second gun, called No. 17, the report is as follows:

> This was the same gun as No. 14, with some slight modifications. * * * Five hundred shots were fired. Thirty-nine missfires during the test, some of which required several pulls of the firing pin to explode the primer. * * * Gun opened and worked with difficulty, requiring the use of the mallet. After opening, the cap to the magazine would not at first spring back to its place; 5 missfires. * * * Extractor broken and head of shell blown nearly off, and shell taken out by use of bullet and rammer.

As to the third gun, called No. 40, the report is as follows:

> The Russell gun, No. 17, having been modified as explained below, was reentered as No. 40. * * * Five hundred shots were fired. * * * Gun thoroughly rusted. Opened with great difficulty, requiring the use of mallet and water, after which could not be made to operate without cleaning up and repairing, and the tests were abandoned.

The final recommendation of the board was that a number of the Lee, Chaffee-Reece, and Hotchkiss guns be purchased for trial in the hands of troops, these three being the only guns which met the tests preestablished by the board. As the appellants were present and were given an opportunity to test their gun themselves, it can not be doubted that the tests were fair, and that the gun was rejected on its merits. (See House Ex. Doc. No. 1,

Forty-seventh Congress, second session, Ordnance, part 2, vol. 3, pp. 329 *et seq.*)

Similarly, if the submission of the appellants' gun to the board of officers in 1893 constituted an offer, there was certainly no acceptance, for the board's action involved a second rejection of the gun. The three guns of 1882 were again presented, and the report is as follows:

> Capt. A. H. Russell, Ordnance Department, appeared before the board and submitted three guns of his invention. As, however, they were not of caliber .30, but of caliber .45, and not in condition for firing, no tests could be made, Captain Russell merely explaining their mechanism to the board. (Rept. of the Chief of Ordnance, 1892, p. 155.)

In view of the repeated rejection and condemnation of the appellants' gun by the boards of officers to whom it was submitted, it is difficult to see why this submission and testing of the gun should have been referred to at all in a petition setting up an implied contract, in the absence of any allegation that the conclusions of these boards were subsequently withdrawn or modified. As far as the action of these boards go, they show not merely a failure to do anything which could be construed into a contract with the appellants, but even a positive refusal to contract with them for the use of their gun.

The facts which the petition seems to rely on most strongly as constituting a contract are the appellant Russell's letter of November 16, 1892 (Exh. A, Rec.,

6–7), the reply thereto (Exh. B, Rec., 7), and the subsequent correspondence (Exhs. C to K, Rec., 7–14), coupled with the Krag-Jörgensen contract and bond and the manufacture of the rifles. It is hard to see how the letter of November 16, 1892, can be regarded as an offer to contract, since it is merely a notice that the Krag-Jörgensen gun "infringes" the appellants' patent, and a request that, in considering the allowance to inventors, the appellants' "claims for these vital points of construction be regarded." While the language of this letter is, perhaps, a little obscure, the most reasonable construction to give to it is that it was intended, in the first place, to notify the Chief of Ordnance that the gun submitted by the Krag-Jörgensen Company, and recently adopted by the War Department, infringed the appellants' patent, so that the proposed manufacture of guns of this type by the United States would infringe that patent; and, secondly, to request that the claims which the appellants would have for compensation on account of such infringement should be regarded. The word "claims" can not refer to claims on account of a contractual use of the appellants' invention, for no contract is mentioned or even suggested. The letter refers only to an alleged infringement by the Krag-Jörgensen Company, and, by direct inference, to an expected infringement by the United States, and hence the "claims" must be understood to be those which would result from such expected infringement. A warning that a certain course of action will be a tortious violation of a person's rights, coupled

with a request that the claims which will result in consequence of such tort shall be considered and compensated for when they arise, is not and can not be the same thing as an offer to enter into a contract.

Whatever be thought of the letter of November 16, 1892, the Ordnance Office reply of November 18, 1892 (Exh. B), has certainly none of the elements of the acceptance of an offer to contract. While this letter does not contain the word "infringement," yet, as the letter to which it was a reply referred solely to the matter of infringement, the former must be understood as referring to the same thing. The letter states that in case the Krag-Jörgensen Company agrees (as it eventually did) to indemnify the United States on account of any patent rights which may affect the manufacture of the guns, the claimants' recourse would be to communicate with the company, while if there should be no such arrangement for indemnity the appellants could sue the United States after manufacture had progressed. It is true that the bond eventually given is one upon which the appellants can not sue, and also that whatever rights of suit the appellants may have can not be limited to such as the Ordnance Office may inform them that they have; but it is equally true that the only right of suit referred to in this letter—especially if taken in connection with that to which it was an answer—was the right to sue for an infringement, not the right to sue upon a contract.

It is immaterial that, as a matter of law, the United States can not be sued for an infringement, that being

a tort. When the letter in question was written, and until November, 1894, when *Schillinger* v. *United States* (155 U. S., 163) was decided, it was believed that as patents were granted in pursuance of the Constitution and of acts of Congress, a claim for an infringement was based upon the Constitution and upon acts of Congress, and hence came within the jurisdiction of the Court of Claims. Apart from this, though, the important matter is not whether the Ordnance Office was right in its understanding of the law, but *what it understood* in regard to the subject-matter of this letter.

This letter of the Ordnance Office, then, is simply an admission that if it infringes the appellants' patent, thereby committing a tort against them, the appellants can sue the Government. It is not, and can not have been intended as, an acceptance of an offer to contract.

If there could be any doubt as to the position in which the appellants and the Ordnance Office stood as regards each other in this matter when the letter of November 16 and the reply of November 18 were written and received, it would be set at rest by the subsequent correspondence between the parties (all of which is made a part of the petition), wherein an infringement is always the thing referred to, and never a contract. The material portions of this correspondence are as follows:

> Exhibit C (Rec., 7–8). Russell to Chief of Ordnance, December 9, 1892: "I desire to say that I could practically have no remedy *for infringement* of my patent against the Krag-Jörgensen

Company, as they have not, that I am aware of, any property in this country."

Exhibit E (Rec., 8–9). Russell to Commissioner of Patents, February 6, 1893: "I presented to the Ordnance Office the claim that the gun recommended for adoption by the United States Army, known as the Krag-Jörgensen gun, *infringed* claims 22, 28, and 29 of my patent, No. 230823."

Exhibit F (Rec., 9). Commissioner of Patents to Russell, February 14, 1893: "Questions of *infringement* can be determined only by the courts."

Exhibit G (Rec., 9). Russell to Chief of Ordnance, June 30, 1893: "In reference to correspondence regarding *infringement* of my patent, No. 230823, by the manufacture of the Krag-Jörgensen magazine rifle recommended by the magazine gun board. * * * The patent *infringed* is one of long standing, and no claim is made that the Krag-Jörgensen patents infringe, but it is claimed that the construction of the gun embodying those patents *does infringe* my patent of 1880."

Exhibit H (Rec., 10). Acting Chief of Ordnance to Russell, July 7, 1893: "The agreement with the Krag-Jörgensen people is such that they are required to guarantee the United States against all damages for *infringement*."

Exhibit I (Rec., 10–14). Russell to Chief of Ordnance, November 22, 1893: "My belief is sustained by expert opinion that the Krag-Jörgensen gun under construction at Springfield *infringes* the twenty-second claim of my patent. * * *

> "I therefore feel warranted in the belief that my claim 28 covers the Krag-Jörgensen construction and is *infringed* thereby. * * *
>
> "I therefore base my claim for compensation on the *infringement* of my claims 22 and 28, and the probable *infringement* of claim 29, in my patent No. 230823. * * *
>
> "My first office notice to the Ordnance Department of this *infringement* is dated November 16, 1892."

The appellants' brief, page 16, contains, however, this statement in regard to this use of the words "infringed" and "infringement:"

> In each instance where one of these words is found it was used to describe the rifle manufactured by the Krag-Jörgensen Gevaerkompagni and presented to the board of 1892. No such term was applied to the prospective use of the claimants' invention by the United States.

It is submitted that out of all the letters in question the only ones which bear out this statement are Exhibits E and F, the letters to and from the Commissioner of Patents, which are of no importance. The words of Russell's first letter, Exhibit A, are, "infringed in the construction of the Krag-Jörgensen magazine gun, lately adopted by the War Department." What the War Department had adopted was not the individual guns sent over by the Krag-Jörgensen Company, but the type of gun. Russell's letter means nothing else than that all guns of this type, wherever and by whomsoever manufactured, infringe the appellants' patent, and hence that as the United States pro-

posed to manufacture such guns, such manufacture would constitute an infringement.

The other communications likewise refer in unmistakable terms to an infringement by the Government. In Exhibit C, Russell wrote: "I could practically have no remedy for infringement of my patent against the Krag-Jörgensen Company." He was evidently not referring to such a trifling matter as that the company had brought into the United States a few guns which he believed infringed his patent. It would never have occurred to him to proceed against the company for that. What he meant, and the only thing that he could possibly have meant, was that when the Government proceeded to manufacture guns of that type he would have no practical remedy against the Krag-Jörgensen Company for the infringement involved in such manufacture by the United States. That would be a serious matter, as the number of such guns would be great, and that would be the infringement for which he wished a remedy.

So in Exhibit D, where the Chief of Ordnance referred to "the subject of infringement of your patent in the manufacture of the Krag-Jörgensen magazine firearm," there can be no question as to what manufacture was meant. It was the Government's manufacture, and nothing else.

Exhibits G, H, and I all refer to this same matter of an infringement by the Government. In Exhibit I Russell was particularly explicit on this point, saying:

> I hereby respectfully state my position with regard to the Krag-Jörgensen rifle construc-

> tion recently adopted for the U. S. Army, and *now in process of manufacture at the Springfield armory.* * * * My belief is sustained by expert opinion that the Krag-Jörgensen gun *under construction at Springfield* infringes the 22d claim of my patent. (Rec., 10, 12.)

In view of such statements as these, it is going rather far for the appellants to now contend that they never spoke of the manufacture of the Krag-Jörgensen gun by the United States as an infringement, or that, even if they did so speak of it, they can now treat it as having been carried on under an implied contract all the time. In fact, the former contention must be passed by as too unreasonable to warrant further discussion, and the latter contention need alone be considered. This contention involves the admission that when they used the words "infringe" and "infringement" so repeatedly they did not know the purport of these words, and that what they really meant all the time was that the manufacture of the Krag-Jörgensen gun would raise a contract to pay them a royalty upon their patent; or, in other words, that while the language which they used all along purported to relate to a demand for compensation for a tort, it really concerned an offer to contract. This is certainly an astounding admission for grown men to make.

Even if the appellants could be heard to say, in effect, that in using the word "infringement" they did not really mean an infringement, it still would not follow that the officers of the Ordnance Office were equally

careless in their use of language, or that they intended, when writing about an infringement, to enter into any relations with the appellants from which a contract could be implied. The petition does not allege that the ordnance officers used the word "infringement" in the sense of "contractual use," and, in the absence of proof that they did, it must be conclusively presumed that when they said "infringement" they meant an infringement, and nothing else.

In this connection it is well to notice the language used by this court in an action against a Government officer for an infringement:

> The United States, by successive acts of Congress, have consented to be sued upon their contracts. * * * The United States may accordingly be sued by a patentee for their use of his invention under *a contract made with him* by the United States or by their authorized officers. *United States* v. *Burns*, 12 Wall., 246; *United States* v. *Palmer*, 128 U. S., 262; *United States* v. *Berdan Co.*, 156 U. S., 552.
>
> But the United States have not consented to be liable to suits, founded in tort, for wrongs done by their officers, though in the discharge of their official duties. * * * The United States, therefore, are not liable to a suit for an infringement of a patent, that being an action sounding in tort. *Schillinger* v. *United States*, 155 U. S., 163; *United States* v. *Berdan Co.*, 156 U. S., 552. (*Belknap* v. *Schild*, 161 U. S., 10.)

The opinion just quoted from is important, not merely as a reaffirmance of the doctrine of *Schillinger* v. *United*

States, but as containing an explicit statement of what was decided in *United States* v. *Berdan Co.*, viz, that a contract *had been made* between the parties. The opinion in that case uses the following language in regard to the contract:

> Berdan, as an officer of the plaintiffs herein, assignees of his inventions during the period covered by this action, was in constant communication with the ordnance officers, requesting the use of his devices by the Government. They knew him as an inventor, and knew his inventions as soon as they were patented. * * * Plaintiffs have desired the Government should use their patented devices, and have also desired and requested compensation for such use. So far, then, as the petitioner is concerned, the use of this invention was with its consent, in accordance with its wish, and with the thought of compensation therefor.
>
> While the findings are not so specific and emphatic as to the assent of the Government to the terms of any contract, yet we think they are sufficient. There was certainly no denial of the patentee's rights to the invention; no assertion on the part of the Government that the patent was wrongfully issued; no claim of a right to use the invention regardless of the patent; no disregard of all claims of the patentee, and no use in spite of protest or remonstrance. Negatively, at least, the findings are clear. The Government used the invention with the consent and express permission of the owner, and it did not, while so using it, repudiate the title of such owner. (156 U. S., 567–568.)

The opinion then went on to quote the findings in regard to the then noncommittal policy of the War Department toward inventors, the Chief of Ordnance's statement that if any of the features of Berdan's patent should be used in the manufacture of the Government's gun he expected to recommend payment, the understanding of a subsequent Chief of Ordnance that the Springfield extractor-ejector was the mechanical equivalent of the device of Berdan, who would have to be paid if his patent was valid and was used, and the subsequent manufacture of the Springfield gun, with this understanding, and "with the expectation that if the court sustained a claim by Berdan against the Government upon his patent No. 88436, then the Government must pay him for the use of the invention." The import of these findings was said to be this:

> That the officers of the Government, charged specially with the duty of superintending the manufacture of the muskets, regarded Berdan as the inventor of this extractor-ejector; that the difference between the spiral spring and the flat spring was an immaterial difference; that, therefore, they were using in the Springfield musket Berdan's invention; that they used it with his permission as well as that of his assignee, the petitioner, and that they used it with the understanding that the Government would pay for such use as for other property which it might take, and this, although they did not believe themselves to have the authority to agree upon the price. (156 U. S., 569).

The above facts were held to show the existence of

"a contract to which both parties assented," or, to quote the language of *Belknap* v. *Schild* (*supra*), "a contract made with [the patentee] by the United States:" but these facts differ widely from those found in the present case. The present petition sets up no request by the appellants that the Government, which had twice rejected their gun as a whole, should use some part of it in connection with another device which had been adopted, but merely a warning that the manufacture of the adopted gun would constitute an infringement. So far as the appellants are concerned, the alleged use of their device appears to have been without their consent, not in accordance with their wish, though with the desire on their part for compensation for the alleged tortious infringement.

As concerns the appellee's position, the dissimilarity between the two cases is even more clearly shown. The former noncommittal attitude* of the War Department toward inventors (an attitude due apparently to the fact, pointed out by this court, that the officers "did not believe themselves to have the authority to agree upon the price") had ceased to exist, as is conclusively shown by the fact that the Department did admit the legal rights of Messrs. Krag and Jörgensen as inventors, and did decide upon their claims against the Government, by making an express contract with their assignee for the right to manufacture on payment

*It should not be overlooked that this noncommittal attitude, now manifestly a thing of the past, is a matter of fact, not of law. It is not alleged in the petition, and hence is not one of the facts which are before the court.

of a fixed rate of royalty. There was no hesitation about dealing directly with inventors or their assignees, or passing upon the money value of inventions, or agreeing to pay a price. There was no recognition whatever of even the possible identity of any part of the appellants' device with any part of the Krag-Jörgensen gun, nothing whatever to correspond to General Benét's understanding, in the Berdan case, that the device used was "seemingly identical, certainly the mechanical equivalent" of that patented to Berdan. Lastly, there was no such understanding, on the part of the officers of the Government, that the Government would pay the present appellants for the use of their invention, as was found to have existed in the Berdan case.

What the present petition sets up, as regards the acts of the appellee, is the original statement that if the Krag-Jörgensen Company agreed to be responsible for infringements the appellants could sue them, and if not, then they could sue the United States, followed by the later statement that the Krag-Jörgensen Company had so agreed, coupled with a suggestion that the appellants furnish the Ordnance Office with a statement of the case for future reference, and the final statement that the case "can not be determined by the Ordnance Department." There is no suggestion of a contract in these statements of the ordnance officers.

Had the ordnance officers been the owners of a gun factory or the officers of a firearms manufacturing

company, it could not possibly have been contended that in doing and saying what they are alleged to have said and done they had contracted with the appellants; and this court has laid it down that Congress "has limited the jurisdiction of the Court of Claims to cases arising out of contracts expressed or implied—contracts to which the United States is a party *in the same sense that an individual might be*, and to which the ordinary principles of contracts must and should apply." (*Smoot's Case*, 15 Wall., 36, 45.) Under that decision it is clear that if the present petition, supposing it to be filed against a firearms manufacturing company, would not be held to set up a cause of action sounding in contract, the mere fact that it is filed against the United States can not alter the nature of the action. "An implied contract is founded upon a presumed agreement" (*Simpson* v. *United States*, 31 C. Cls. R., 217, 245), but in the present case, as in that of Schillinger, "there was no point in the whole transaction from its commencement to its close where the minds of the parties met or where there was anything in the semblance of an agreement." (*Schillinger* v. *United States*, 155 U. S., 163, 170.)

In *Coston* v. *United States* (33 C. Cls R., 438, 447) the Court of Claims said:

> The petition sets forth alleged dealings at various times with the Department of the Navy in relation to these signals, * * * but it does not state an admission at any time by defendants that they were using the device

covered by the Coston patent here under consideration. The petition therefore could be properly dismissed upon demurrer.

In the present case the petition has the same defect that would have been held fatal in the Coston case, had a demurrer been based upon it. The present petition does, it is true, allege, as a matter of deduction from the facts stated, that a contract is to be implied, "whereby the United States agreed to pay to the claimants reasonable compensation," etc., but it is precisely this alleged agreement the legal existence of which is called in question by this demurrer. Except as a matter of deduction, there is no allegation of an admission by the United States that it was using, or might possibly be using, the appellants' device. The furthest that the facts go in this direction is to show a statement that if the appellants believed their patent to be *infringed* they could sue for such infringement, but that the appellants were, or might be, justified in such a belief was in no way admitted by the officers of the Government.

The appellants' brief starts out with the proposition that the officers of the United States must be understood to have agreed to allow the appellants "such reasonable compensation as might become due them for the use which it [the United States] made of their property," because the only other theory which appellants' counsel can see in the case is the untenable one "that the military invited inventors to present their devices with the intention of defrauding or injuring" the persons who did so. The case involves no such

dilemma, however. Undoubtedly the inventors who submitted their guns in 1882 and 1892 were entitled to expect that any person or persons whose gun was adopted would receive compensation, but the appellants' gun never was adopted. On the contrary, it was rejected. If any patented portion of its design has actually been used in the gun which was adopted, the Government officers have never admitted that this has been done, and it can not possibly be contended that it was done intentionally or knowingly. The Government did not seek to incorporate into the design of the gun which it adopted a single feature of any of the numerous guns of other designs which were submitted to it. It simply adopted one single type of gun which had been submitted to it as a complete whole, and which those who offered it declared was not covered as to any feature by any other patents than their own. The fact that a bond was given for the Government's protection against claims on account of the patents of other parties does not mean that the Government did not rely, and rely confidently, upon the declaration of the Krag-Jörgensen Company, but merely that it was realized that in this, as in every other human declaration, there was a possibility of error. The officers of the Government have never said to the appellants, "If we are using any part of your patented invention, we will pay you," nor can anything which they wrote or did be tortured into such a promise. What they said was that if the appellants believed that their patent would be *infringed* by the

manufacture of guns of the Krag-Jörgensen type, and there should be no remedy against the Krag-Jörgensen Company, their course would be "to bring a suit" (i. e., a suit for such infringement) "against the Government in the Court of Claims after manufacture has progressed." This is no acceptance of a contract.

The appellants' brief seeks to bring the present case within the doctrine of *McKeever* v. *United States* (14 C. Cls. R., 396, affirmed without opinion), but the facts of the two cases are wholly dissimilar. McKeever's patented device was submitted to a board, and was adopted with full knowledge of all the facts. That such a device would have to be paid for was just as evident as that the Krag-Jörgensen gun, when adopted and manufactured, would have had to be paid for, even if there had been no express contract. When the Court of Claims, in *Kelton* v. *United States* (32 C. Cls. R., 314, 341), said that McKeever had "recovered for what, as between individuals, would be an infringement of his patented device," all that was meant was that, as between individuals, any making of a patented invention, not under an express contract, constituted an infringement, and that a recovery could be had for it as such; or, in other words, that even if an individual intends and agrees to pay a reasonable royalty, he can be sued for an infringement, if no express contract has been entered into, but the Government must be sued upon its intention and agreement. Had the Court of Claims meant more than this, it would have violated the doctrine of *Smoot's Case*, already cited.

In *Butler* v. *United States* (23 C. Cls. R., 335, not appealed) the statement of facts is meagre, but it is to be inferred from the opinion that the statement in the petition that the "patentees and assignees offered the use of said improvement to the United States, which offer the United States, after careful investigation, accepted," was not disputed by the defendant. The opinion expressly states that "the only question of law involved in the case is as to the running of the statute of limitations." The court below has obviously held that its decision in that case furnished no precedent for a case like the present, where the appellee denies that it has accepted any offer made by the appellants.

It is therefore submitted that the judgment of the court below should be affirmed.

CHARLES C. BINNEY,
Special Attorney.

LOUIS A. PRADT,
Assistant Attorney-General.

○

Supreme Court of the United States.

No. 242.—October Term, 1900.

Andrew H. Russell and William R. Livermore, Appellants, *vs.* The United States. } Appeal from the Court of Claims.

[May 27, 1901.]

This is an action for $100,000, brought in the Court of Claims by the appellants, upon an implied contract, asserted to have arisen from the use by the United States of Krag-Jorgensen rifles, which rifles contained, it is claimed, certain features, which were the invention of Russell, one of the appellants. The United States demurred to the petition, and the demurrer was sustained.

The facts as presented by the petition are as follows: That on or about August 3, 1880, letters patent No. 230,823, for certain new and useful improvements in firearms, were granted to Russell, and that he and Livermore are now the owners of such invention.

That pursuant to an advertisement by a board of officers convened under the act of Congress, approved February 4, 1881, to select a magazine rifle for the service of the United States, Russsell submitted to said board an operative magazine rifle made in accordance with his letters patent, and on or about December 16, 1890, submitted to another board of officers, convened for like purpose, the same rifle. The officers made reports on the rifle, which reports, it is alleged, may be found in certain Congressional documents designated by number and of the session of Congress of whose records they constitute a part.

On the 15th of September, 1892, a second board recommended the adoption of the magazine rifle presented to it by the Krag-Jorgensen Gevaerkompagni of Christiania, Norway, and the rifle was provisionally adopted by the War Department for the use of the United States Army. The rifle is termed in the petition "Army rifle."

The petition recites a correspondence between Russell and the Chief of Ordnance of the United States Army, giving its substance, which may be omitted, as the letters are hereafter set out in full.

It is also alleged that on June 7, 1893, the Krag-Jorgensen Gevaerkompagni and the United States, represented by Brigadier General D. W.

Flagler, United States Army, Chief of Ordnance, under the direction and by the authority of the Secretary of War, entered into a contract, whereby that company granted to the United States the right to manufacture an unlimited number of said "Army rifles." As much of the contract as we consider important is hereinafter set out.

That the United States did proceed to manufacture said "Army rifles," and introduce them for use in the United States Army, and since January 1, 1894 commenced to account, and has ever since accounted, to the Krag-Jorgensen Company for royalties, at the rate named in the contract, and paid certain sums on account thereof. The company failed to furnish an indemnifying bond, but the United States, with consent of the company, withheld a certain amount of the royalties, which aggregated on or about June 16, 1895, the sum of $25,000. The company then gave a bond with sureties, and the said sum was paid to it. The bond was conditioned as follows:

"That whereas the Krag-Jorgensen Gevaerkompagni of Christiania, Norway, has, on the seventh day of June, 1893, entered into a contract with the United States, represented by Brigadier General D. W. Flagler, Chief of Ordnance, for granting unto the United States full rights to manufacture an unlimited number of the Krag-Jorgensen magazine firearms, for the military service of the United States, under the American patents Nos. 429,811, of June 10, 1890, and 492,212, of February 21, 1893, granted to O. W. J. Krag and E. Jorgensen, during the lifetime of the said patents, and by the said contract covenanted to indemnify the United States, and all persons acting under them, for all liability on account of any patent rights granted by the United States which may affect the right to manufacture therein contracted for, and further covenanted and agreed to furnish, before the payment of any royalties by the United States, a good and sufficient bond in the penal sum of twenty-five thousand dollars, to protect and defend the United States against all suits and claims by any and all persons for infringement on their inventions in the manufacture of said arms, and to pay all judgments that may be obtained against the United States for the same:

"Now, therefore, if the said Krag-Jorgensen Gevaerkompagni shall and will in all respects indemnify the United States, and all persons acting under them, for all liability on account of any patent rights granted by the United States which may affect the right to manufacture granted by said contract, and shall and will fully protect and defend the United States against all suits and claims by any and all persons for infrinngement of their inventions in the manufacture of said arms, and pay all judgments that may be obtained against the United States, or any officer or agent thereof for the same, then the above obligation shall be void and of no effect; otherwise to remain in full force and virtue."

It is alleged that the United States manufactnred and used upwards of 75,000 "Army rifles" containing Russell's invention, and derived a profit thereby of $1 on each rifle.

The petition concluded as follows:

"By reason of the foregoing facts the claimants say:

"That neither the said contract, entered into by the United States and the Krag-Jorgensen Gevaerkompagni (Exhibit L) nor the said bond of indemnity delivered by the Krag-Jorgensen Gevaerkompagni to the United States, did provide the claimants with a remedy against the said Krag-Jorgensen Gevaerkompagni, for the use made by the United States of the claimants' said patented invention in accordance with the first alternative proposed by the Ordnance Department in its said letter to the claimant Russell, bearing date November 18, 1892 (Exhibit B).

"That there is to be implied from the use by the United States of the claimants' said patented invention, as hereinbefore related, a contract, whereby the United States agreed to pay to the claimants reasonable compensation for the same, and whereby the amount of such compensation was to be ascertained by means of a suit to be brought by the claimants in this court, in accordance with the second alternative proposed in the said letter (Exhibit B), and that the sum of $100,000 would be reasonable compensation for the said use, and that the United States has failed to pay the claimants the said sum of $100,000, or any sum or sums whatsoever for or on account of the said use, although duly requested thereunto.

"The claimants are the only persons owning or interested in the claim above set forth, and no assignment or transfer of the said claim or of any part thereof or interest therein has been made. The claimants are justly entitled to receive and recover from the United States the sum of one hundred thousand dollars ($100,000), after allowing all just credits and offsets. The claimants have always borne true allegiance to the government of the United States, and have not in way aided, abetted or given encouragement to rebellion against the said government, and they believe the facts hereinabove stated to be true.

"Wherefor the claimants pray for judgment against the United States in the sum of one hundred thousand dollars ($100,000), and for such further relief as this honorable court may be entitled to grant, both at law and in equity, in the premises."

The following is the correspondence:

"EXHIBIT A.

(Copy.)

"Washington, D. C., November 16, 1892.

"To the Chief of Ordnance, U. S. Army.

"Sir: In the interest of Major Wm. R. Livermore, U. S. Army, and myself, I have the honor to invite attention to claims 22, 28 and 29 in U. S. patent No. 230,823, owned by us, as we believe their provisions to be infringed in the construction of the Krag-Jorgensen magazine gun lately adopted by the War Department, the points of resemblance being in the connection between the magazine and the receiver.

"In considering the allowance to inventors, we would request that our claims for these vital points of construction be regarded.

Very respectfully, your obedient servant,

(Signed) A. H. RUSSELL,
Capt. of Ordnance, U. S. Army.

"EXHIBIT B.

5839.

"Ordnance Office, War Department,
Washington, November 18, 1892.

"Capt. A. H. Russell, Ordnance Department, U. S. A., cor. 15th St. and N. Y. Ave., Washington, D. C.

"Sir: In reference to your letter of the 16th instant claiming the use of your patent right in the Krag-Jorgensen gun, lately adopted by this department for trial, which has been received and placed on file, I am instructed by the Chief of Ordnance to inform you that the business arrangements with the Krag-Jorgensen Company for the manufacture of this arm have not yet been completed.

"On the one hand, that company may agree to indemnify the United States on account of any patent rights granted by the United States which may affect the manufacture of the guns, in which case your recourse would be to communicate directly with the company.

"On the other hand, should the government proceed to manufacture the arms without such arrangement, your course will be to bring a suit against the government in the Court of Claims after manufacture has progressed.

Respectfully, (Signed) C. W. WHIPPLE,
Capt. Ord. Dept., U. S. A.

"EXHIBIT C.

"Washington, D. C., December 9, 1892.

"To the Chief of Ordnance, U. S. Army.

"Sir: In reference to my letter to the Chief of Ordnance of November 16, 1892, and to the answer of November 18th from the Ordnance Office in reply thereto, concerning the claims 22, 28 and 29 in the U. S. patent to me, No. 230,823 (a copy of the specifications on which was enclosed in my letter), I desire to say that I could practically have no remedy for infringement of my patent against the Krag-Jorgensen Company, as they have not, that I am aware of, any property in this country; and also that I presume it would be more satisfactory to the United States, as it certainly would be to me, to have whatever may be justly due to me on my patents allowed without litigation.

"I therefore hope that the Ordnance Office will bear my letter of November 16th, and this letter, in mind, and allow me a hearing before any business arrangement with the Krag-Jorgensen Company is closed.

Very respectfully, your obedient servant,

(Signed) A. H. RUSSELL,
Capt. of Ordnance, U. S. Army.

"EXHIBIT D.

"Ordnance Office, War Department,
Washington, December 19, 1892.

"Capt. A. H. Russell, World's Columbian Exposition, Chicago, Ill.

"Sir: Referring to your letters of the 16th ult. and the 9th inst., on the subject of infringement of your patent in the manufacture of the

Krag-Jorgensen magazine firearm, I am instructed by the Chief of Ordnance to inform you that in a letter received from the Commissioner of Patents dated 15th inst. he states that the invention of H. I. Krag and Erik Jorgensen for improvement in machine firearms has been examined and the invention has been found patentable in view of the state of the art, but that other applications are pending which appear to conflict in subject-matter; therefore the application of Krag and Jorgensen will be withheld from issue until that question is settled definitely.

"I am also instructed to inform you that in a letter to the Commissioner of Patents, dated 16th inst., the Chief of Ordnance transmitted to him copies of your above-mentioned letters of 16th ult. and 9th inst.

"Should you desire further presentation of your patent, it is suggested that you communicate direct with the Commissioner of Patents.

Respectfully, (Signed) CHARLES SHALER,
Capt. Ord. Dept., U. S. A.

"EXHIBIT E.

"1429 New York Ave.,
Washington, D. C., February 6, 1893.

"To the Commissioner of Patents.

"Sir: In an official communication from the Chief of Ordnance U. S. A., dated December 19, 1892, it is suggested that I 'communicate direct with the Commissioner of Patents' in regard to the following matter.

"I presented to the Ordnance Office the claim that the gun recommended for adoption by the U. S. Army, known as the Krag-Jorgensen gun, infringed claims 22, 28 and 29 of my patent No. 230,823, dated August 3, 1880, and I ask that the government do justice by me in case of using such device.

"The Chief of Ordnance states that there were claims now pending in the Patent Office, and referred me to you, with the information that copies of my letters had been sent you December 16, 1892.

"Copies of these letters are enclosed, with copies of replies from the Ordnance Office.

"I have the honor to inquire what further action should be taken by me.

Very respectfully, (Signed) A. H. RUSSELL.

"EXHIBIT F.

"Department of the Interior, United States Patent Office,
Washington, D. C., February 14, 1893.

"Capt. A. H. Russell, U. S. A., 1429 New York avenue, Washington, D. C.

"Sir: I have your letter of the 6th instant, and in reply you are advised that it is not seen how the Patent Office has any jurisdiction in the matter concerning which you write. Questions of infringement can be determined only by the courts.

Very respectfully, (Signed) W. E. SIMONDS.
12,509 Div. A–1893. *Commissioner.*

"EXHIBIT G.

"Chicago, Ill., June 30, 1893.

"To the Chief of Ordnance, U. S. Army, Washington, D. C.

"Sir: In reference to correspondence regarding infringement of my patent No. 230,823 by the manufacture of the Krag-Jorgensen magazine rifle recommended by the magazine gun board, I have the honor to state that I communicated direct with the Commissioner of Patents, as suggested in the letter of December 19, 1892, from the Ordnance Office, and was told that the Patent Office had no jurisdiction. The patent infringed is one of long standing, and no claim is made that the Krag-Jorgensen patents infringe, but it is claimed that the construction of the gun embodying those patents does infringe my patent of 1880.

"I therefore respectfully renew the request contained in my letter of December 9, 1892, that the Ordnance Office will 'allow me a hearing before any business arrangement with the Krag-Jorgensen Company is closed.'

Very respectfully, your obedient servant,

(Signed) A. H. RUSSELL,
Capt. of Ord., U. S. Army.

"EXHIBIT H.

(1st endorsement.)

"Ordnance Office, Washington, July 7, 1893.

"Respectfully returned to Capt. A. H. Russell, Government Building, Jackson Park, Chicago, Ill., with information that a statement of this case should be made in writing for file at this office, and for future reference, as the case stated cannot be determined by the Ordnance Office.

"The agreement with the Krag-Jorgensen people is such that they are required to guarantee the United States against all damages for infringement.

(Signed) CHARLES SHALER,
Acting Chief of Ordnance.

"EXHIBIT I.

"Chicago, Ill., November 22, 1893.

"To the Chief of Ordnance, U. S. Army, Washington, D. C.

"Sir: In response to your communication of July 7, 1893, in the 1st endorsement on my letter of June 30, 1893, Ordnance Office files 3515 of 1893, I hereby respectfully state my position with regard to the Krag-Jorgensen rifle construction recently adopted for the U. S. Army, and now in process of manufacture at the Springfield Armory.

"I do not claim to be the inventor of all the mechanism of said gun. There are probably several important and meritorious inventions involved. The grant of a patent by the Patent Office on some features, however, does not authorize the making or using of other features covered by other patentees, as I am informed, and as seems a reasonable construction of law.

"The specific features used in said gun and claimed by me, and believed to be covered by my U. S. patent No. 230,823 of August 3, 1880, are

embraced in the 22d, 28th and possibly in the 29th claims of said patent. A free description of the general features of my invention as used in the Krag-Jorgensen gun would be 'a magazine feeding into the side of the receiver under a bridge, with the entrance way under the bridge narrowed at the rear of the receiver, so as to permit but a slight projection of the side of the cartridge into the receiver when the bolt is drawn back, but with a wider opening further forward, so that as the cartridge moves forward impelled by the bolt, it will find a full-width passage under the bridge, through which passes into the receiver.'

"This bridge and magazine opening is described in my patent, referred to, page 6, lines 100 *et seq.*, as follows:

'In filling the chamber of the magazine the gate is forced downward as the cartridges are filled in, leaving ample space to insert cartridges between the top edge of the magazine wall and a bridge or top part, M, and thus supply the magazine. When relieved of the downward pressure the gate ascends far enough to prevent egress of cartridges in any other way than sidewise from the magazine mouth into the receiver B′ beneath the bridge.

'The bridge M is of peculiar formation on its under and inner surface, and is at one side of the longitudinal center of the barrel and breech-bolt housing. (See particularly Figs. 9, 10, 11, 12, 13 and 14, where is represented the manner of curving or recessing the bridge so as to admit cartridges to the receiver and guide and control their movements as supplied to the receiver from the magazine mouth, and thence conducted to firing chamber by the thrust of the breech bolt A^2.)

'Supposing the breech bolt to be retraced and about to be advanced, the operation of supplying and seating a cartridge from the magazine is as follows, reference being had to the last referred to figures and to Figs. 3, 4 and 6, ignoring for the present the hinged gate N: The topmost cartridge is elevated by the pusher against the bridge, so that its flange projects partially, but very slightly, into the path of travel of the breech-bolt head, (see dotted lines, Fig. 11,) and in which position it is prevented from accidental inward movement by a slight ridge or swell, *n*, (see Figs. 4 and 11,) at the rear portion of the edge or wall of the opening in the receiver bottom, with which the magazine communicates, and by a similar ridge or downward swell, *n′*, on the bridge.

'The point or nose of the cartridge is guided past the spring *l* and into the firing chamber *b*, by the flaring way or incline *m* as the bolt advances.

'Before the cartridge has been moved forward far enough by the advance of the bolt to jam or bind crosswise, the flange will have been moved to a point where the two ridges *n n′* begin to slope respectively downward and inward gradually to the plane of the bottom or lowest part of the receiver, and upward and inward, thus allowing the flange to pass toward its place in the receiver. The bridge is also cut away on a curve or incline m^2, forward and inward from its lower edge to *m′*, so that as the front of the cartridge is entering the chamber the rear is being gradually brought into line therewith.

'About the time the flange has been advanced to the point indicated by *m′*, Fig. 9, the curved recess or incline m^2 of the inner and under side of the bridge, which had previously served to gradually admit the inward passage of the flange, and which at this point terminates in a swell or ridge similar to *n′*, now serves to prevent its escape or outward movement

and to direct it into the proper position to be pushed home and firmly seated by the bolt, as already described. . . . The bridge M is shown as formed with or attached to the magazine. It may, however, obviously be formed with the shoe or breech of the gun partly over and at one side of the receiver chamber.'

"In the main, this description applies to the Krag-Jorgensen gun quite as well as to my own gun, and my opinion is confirmed by that of experts that this part of my construction has been adopted in that arm.

"I am informed that my rights under my patent depend on the claims therein, and my belief is sustained by expert opinion that the Krag-Jorgensen gun under construction at Springfield infringes the 22d claim of my patent, which reads as follows:

'22. The combination of the shoe chamber or receiver, the bridge at the side and top of the receiver, and the magazine chamber having an inlet to receive the cartridges inserted downward outside and beneath the bridge, and a mouth to conduct them beneath the bridge into and at the side of the receiver, substantially as hereinbefore set forth.'

"Taking the elements of this claim separately, it will be seen that the Krag-Jorgensen gun has 'the shoe or receiver.' All bolt guns and many others have it. The Krag gun is, however, one of a few to have 'the bridge at the side and top of the receiver.' It also has 'the magazine chamber having an inlet to receive the cartridges inserted downward outside and beneath the bridge.' It is true that the Krag-Jorgensen gun shows the loading opening in a different place from that illustrated in my patent, but my claim is not limited as to the exact location of the loading opening, and the whole tenor of my patent is against the theory that I am limited in this claim to the precise construction shown in my drawing. Further, I am informed that the rule of law is that a patent claim, if valid, covers its mechanical equivalents—that is, other devices operating in a similar way to a like result, which is certainly the case in this instance. My claim further specifies 'a mouth by which to conduct them' (the cartridges) 'beneath the bridge into and at the side of the receiver, substantially as hereinbefore set forth.' This language, like the rest of the claim, applies quite as well to the Krag-Jorgensen gun as to the one invented and constructed by me.

"It thus seems demonstrable that the Krag-Jorgensen gun, having adopted part of my invention, has also adopted that part covered by claim 22.

"Claim 28 in my specified patent is as follows:

'28. The combination, substantially as hereinbefore set forth, of the reciprocating breech bolt, the shoe chamber or receiver, the magazine chamber having a mouth, as described, the catridge-supplying mechanism, and the bridge M, having the ridge or swell *n'*, and otherwise curved or recessed, substantially in the manner and for the purpose set forth.'

"The Krag-Jorgensen gun has 'the reciprocating breech bolt, the shoe chamber or receiver, the magazine chamber having a mouth;' it has 'cartridge-supplying mechanism;' and 'the bridge having the ridge or swell' below the main part of the bridge and extending forward precisely in the same manner and for the same purpose as the swell *n'* of my patent, and is otherwise curved or recessed substantially in the manner set forth in my patent. I therefore feel warranted in the belief that my claim 28 covers the Krag-Jorgensen construction, and is infringed thereby.

"Claim 29 of my patent is as follows:

'29. The bridge M, located relatively to the receiver and mouth of the magazine essentially as shown and described, and having the rear ridge n', and the curved or inclined surfaces m' and m^2, substantially as and for the purpose hereinbefore set forth.'

"The construction of the Krag-Jorgensen gun substantially conforms to the terms of this claim also, yet I am not quite certain that the bridge in that gun has a projection the equivalent of that described as m^2 in my patent. I presume this question can only be determined by careful expert examination.

"I, therefore, base my claim for compensation on the infringement of my claims 22 and 28, and the probable infringement of claim 29, in my said patent No. 230,823, of August 3, 1880, by the Krag-Jorgensen construction.

"I am not fully informed as to the terms of the contract between the United States and the owners of the Krag-Jorgensen patent. Assuming that the owners of said patent are in ignorance of my rights in the premises, I respectfully request that a copy of this communication may be sent to the said parties, and a duplicate of this paper is forwarded for that purpose, with an extra copy of my patent to go with the duplicate. I further request that I may be furnished with the name and address of the responsible parties representing the Krag-Jorgensen interest.

"I am aware that in the event of a suit in equity, the alleged infringing parties have a statutory right to challenge the validity of my patent, and, to avoid litigation, I am willing to go further than to make a mere statement of the *prima facie* case as above, and show to infringing parties or their experts that my claims are well within my rights, provided I am met by these parties in a fair spirit, and with a desire to make a just compensation when my title to the property is shown.

"My first official notice to the Ordnance Department of this infringement is dated November 16, 1892, (Ordnance Office file 5839 of 1892,) but a gun presenting the special features here mentioned was submitted by me to the board of magazine guns, convened by General Orders 31, H. Q. A., March 21, 1881, and it is described in the report of that board. It is now in my possession subject to examination.

Very respectfully, your obedient servant,

(Signed) A. H. RUSSELL.

"EXHIBIT K.

(Copy.)

"Ordnance Office, War Department,
Washington, December 1, 1893.

"Capt. A. H. Russell, Ordnance Department, U. S. A., Government Building, Jackson Park, Chicago, Ill.

"Sir: I am instructed by the Chief of Ordnance to acknowledge the receipt of your letter of the 22d inst., and to inform you that the terms of the contract between the United States and the Krag-Jorgensen Company contains a clause to the following effect:

'The said party of the first part shall indemnify the United States and all persons acting under them for all liability on account of any patent

rights granted by the United States which may affect the right to manufacture herein contracted for.'

"You have requested that a copy of your communication and a copy of your patent should be forwarded by this office to the company, and for that purpose you have forwarded duplicates of your letter and of the patent specifications. It is considered best that you should forward these communications direct; they are, therefore, returned to you for the purpose. The address of the contracting company is 'The Krag-Jorgensen Gewehr Kompagnie, Christiania, Norway.' The other papers, enclosures to Ordnance Office file 3515, containing letter and copies of patent specifications, are filed in this office for future reference.

"Your attention is again invited to the statement of the first endorsement on that file, which states that the case 'cannot be determined by the Ordnance Department.'

Respectfully, (Signed) CHARLES SHALER,
Capt., Ord. Dept., U. S. A."

The parts of the contract between the United States and the Krag-Jorgensen Company, which are relevant to the question presented in this case, are as follows:

"It is further stipulated and agreed that before any royalties are paid by the United States, the Krag-Jorgensen Gevarkompagni shall furnish a good and sufficient bond in the penal sum of twenty-five thousand dollars ($25,000.00), to protect and defend the United States against all suits and claims by any and all persons for infringement of their inventions in the manufacture of these arms, and to pay all judgments that may be obtained against the United States for the same.

"2d. All the — herein contracted for shall be delivered by the said party of the first part.

"3d. The said party of the first part shall indemnify the United States and all persons acting under them for all liability on account of any patent rights granted by the United States which may affect the right to manufacture herein contracted for.

Mr. Justice MCKENNA delivered the opinion of the Court.

It is conceded that a contract must be established to entitle appellants to recover, and, it is contended, that one is established by the correspondence between the Ordnance Department and Russell in regard to the use of the "Army rifle," which, it is claimed, contained features of Russell's invention. That is, not an express contract is claimed, but an implied contract is claimed. This court has held that under the act of March 3, 1887, (24 Stat. 505,) defining claims of which the Court of Claims had jurisdiction, that the court had no jurisdiction of demands against the United States founded on torts. (*Schillenger* v. *United States*, 155 U. S. 163; *United States* v. *Berdan Fire Arms Co.*, 156 U. S. 552.) In other words, to give the Court of Claims jurisdiction the demand sued on must be founded on a convention between the parties—"a coming together of minds." That there was such "coming together of minds"

is asserted in the case at bar, and *United States* v. *Palmer* (128 U. S. 262) is cited to sustain the assertion. That case was considered and commented on in *Schillenger* v. *United States, supra*, and it was said to be "an action to recover for the authorized use of a patent by the government, and these observations in the opinion are pertinent: 'This is not a claim for an infringement, but a claim of compensation for an authorized use—two things totally distinct in the law, as distinct as trespass on lands is from use and occupation under a lease. The first sentence in the original opinion of the court below strikes the keynote of the argument on this point. It is as follows: "The claimant in this case invited the government to adopt his patented infantry equipments, and the government did so. It is conceded on both sides that there was no infringement of the claimant's patent, and that whatever the government did was done with the consent of the patentee and under his implied license." We think that an implied contract for compensation fairly arose under the license to use, and the actual use, little or much, that ensued thereon.'"

The facts of the case fully supported the remarks of the court. The petitioner Palmer was the inventor, patentee and owner of improvement of infantry equipments. They were submitted to a board of officers appointed to consider and report upon the subject of proper equipment for infantry soldiers. The board recommended Palmer's invention. The recommendation was approved by the General of the Army and the Secretary of War, and the invention was manufactured by the government and used.

McKeever v. *United States*, (14 Ct. Cl. 396,) affirmed on appeal by this court, rested on the same facts as the Palmer case, the only difference being McKeever's invention was a cartridge box. There was a recommendation by the board, and the manufacture and use of the cartridge box by the government.

But there is a wide difference between the facts in those cases and the facts in the case at bar. The rifle of the petitioners was not adopted by the board; the Krag-Jorgensen rifle was. The contention is, however, that the latter rifle contained some of the features of petitioners' invention, and that by adopting it the Ordnance Department conceded that fact and the rights of petitioners to compensation. We are unable to draw that conclusion from the correspondence, conceding the power of the Ordnance Department to make the concessions.

The first letter of Captain Russell "invites attention to claims 22, 28 and 29" of his patent, and expresses a belief that "the Krag-Jorgensen magazine gun *lately adopted by the War Department*" infringed them "in the connection between the magazine and the receiver." The letter concluded as follows: "In considering the allowance for inventions we would request that our claims for these vital points of construction be regarded." A somewhat

vague request. However, the letter was replied to (November 18), and he was told that "the business arrangements with the Krag-Jorgensen Company for the manufacture of this arm have not yet been completed," and it is represented to him that the company may agree to indemnify the United States, in which case his "recourse would be to communicate directly with the company." Or if the government should proceed to manufacture the arms without such arrangement, his course would be "to bring suit against the government in the Court of Claims after manufacture has progressed." Of what and on account of what was he to communicate to the Krag-Jorgensen Company, and on account of what was he to bring suit against the government? On account of an implied contract which had arisen or would arise between him and the United States? Certainly not but on account of an infringement of his invention which might arise. And this was his interpretation, for he writes on the 9th of December that he "could practically have no remedy for infringement of any patent against the Krag-Jorgensen Company, as they have not, that I am aware of, any property in the United States." He requested a hearing before "any business arrangement with the Krag-Jorgensen Company" should be closed.

In reply to that letter he was told by the Ordnance Department that his letters had been referred to the Commissioner of Patents, and that the Commissioner "states that the invention of H. I. Krag and Erik Jorgensen for improvement in magazine firearms has been examined, and the invention has been found patentable." He is then requested, in "further presentation" of his patent, to "communicate direct with the Commissioner of Patents." He did so, and was informed that it was not seen how the Patent Office had any jurisdiction in the matter. "Questions of infringement," he was told, "can be determined only by the courts." (Letter February 14, 1893.) Waiting until June 30, he informs the Ordnance Department of the reply of the Commissioner of Patents, claimed again the Krag-Jorgensen to be an infringement of his patent and repeated the request of December 9, 1892, that the Ordnance Office allow him "a hearing before any business arrangement with the Krag-Jorgensen Company" be closed. On July 7 that letter was returned to Captain Russell with the endorsement, "that a statement of the case be made in writing for file at this office, and for future reference, as the case stated cannot be determined by the Ordnance Office. The agreement with the Krag-Jorgensen people is such that they are required to guarantee the United States against all damages for infringement."

In answer to this letter Captain Russell's letter of November 22, 1893, (Ex. I,) was written. It need not be reproduced at length. It described his invention and wherein the Krag-Jorgensen rifle infringed that invention, and stated that he based his claim "for compensation on the

infringement" of his claims 22 and 28 "and the probable infringement of claim 29" of his patent No. 230,823, of August 3, 1880, "by the Krag-Jorgensen construction." The letter concluded as follows:

"I am not fully informed as to the terms of the contract between the United States and the owners of the Krag-Jorgensen patent. Assuming that the owners of said patent are in ignorance of my rights in the premises, I respectfully request that a copy of this communication may be sent to said parties, and a duplicate of this paper is forwarded for that purpose, with an extra copy of my patent to go with the duplicate. I further request that I may be furnished with the name and address of the responsible parties representing the Krag-Jorgensen interest.

"I am aware that in the event of a suit in equity the alleged infringing parties have a statutory right to challenge the validity of my patent, and, to avoid litigation, I am willing to go further than to make a mere statement of the *prima facie* case as above, and show to the infringing parties or their experts that my claims are well within my rights, provided I am met by these parties in a fair spirit and with a desire to make just compensation when my title to the property is shown.

"My first official notice to the Ordnance Department of this infringement is dated November 16, 1892, (Ordnance Office file 5839 of 1892,) but a gun presenting the special features here mentioned was submitted by me to the board on magazine guns, convened by General Orders 31, H. Q. A., March 21, 1881, and it is described in the report of that board. It is now in my possession subject to examination."

He received the following reply, which seems decisive against the contention of petitioners that there was a concession of their patented rights and implied contract to compensate petitioners:

"I am instructed by the Chief of Ordnance to acknowledge the receipt of your letter of the 22d instant, and to inform you that the terms of the contract between the United States and the Krag-Jorgensen Company contain a clause to the following effect:

'The said party of the first part shall indemnify the United States and all persons acting under them for all liability on account of any patent rights granted by the United States which may affect the right to manufacture herein contracted for.

'You have requested that a copy of your communication and a copy of your patent should be forwarded by this office to the company, and for that purpose you have forwarded duplicates of your letter and of the patent specifications. It is considered best that you should forward these communications direct; they are, therefore, returned to you for the purpose.'

"The address of the contracting party is 'The Krag-Jorgensen Geivehr-Kompagnie, Christiania, Norway.' The other papers, enclosures to Ordnance Office file 3515, containing letter and copies of patent specifications, are filed in this office for future reference.

"Your attention is again invited to the statement of the first endorsement on that file, which states that the case 'cannot be determined by the Ordnance Department.'"

Not only is the foregoing letter closing the correspondence decisive against petitioners, but we can discern nothing which tends to support their contention and claim. It was not deemed necessary even to grant

his request for a hearing. His rifle was not adopted; another was. There was no concession of his rights. He was told twice that his case could not be determined by the Ordnance Department. There was probably, however, no thought of an arbitrary invasion of his rights. The Ordnance Office sought the opinion of the Commissioner of Patents, and was informed that the Krag-Jorgensen improvement in machine firearms had been examined, and the invention had been found patentable in view of the state of the art. The patent of petitioners was part of the state of the art. The opinion of the Commissioner, of course, was not necessarily conclusive. As he himself said, "Questions of infringement belong to the courts." And because such questions are for the courts the Ordnance Office, no doubt, took indemnity from the Krag-Jorgensen Company, not in concession of petitioners' claim, but for protection against it, if protection should be necessary, and whether it would be or not the Ordnance Office very naturally resolved not to determine. The prudence which takes a bond against a claim cannot be said to constitute or raise a contract in favor of the claim—cannot be said to have intended to create the liability which was meant to be forestalled. Indeed, the Ordnance Office twice wrote Captain Russell that his case could not be determined by it. No contract therefore based on the action of that office can be claimed. If petitioners have suffered injury it has been through the infringement of their patent, not by a breach of contract, and for the redress of an infringement the Court of Claims has no jurisdiction. This doctrine may be technical. If the United States was a person, on the facts of this record (assuming, of course, the petition to be true) it could be sued as upon an implied contract, but it is the prerogative of a sovereign not to be sued at all without its consent or upon such causes of action as it chooses. It has not chosen to be sued in an action sounding in tort this court has declared, as we have seen.

Judgment affirmed.

Mr. Justice HARLAN did not participate in the case, and Mr. Justice SHIRAS, Mr. Justice WHITE and Mr. Justice PECKHAM dissented.

True copy.

Test:

Clerk Supreme Court, U. S.